

This Opinion is Not a
Precedent of the TTAB

Mailed: August 22, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re PTM Guard, SIA

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Serial No. 79248407

Alexander S. Lazouski of Lazouski IP LLC for PTM Guard, SIA.

Robert N. Giuliano, Trademark Examining Attorney, Law Office 105,
Jennifer L. Williston, Managing Attorney.

—
Before Lykos, Goodman, and Larkin,
Administrative Trademark Judges.

Opinion by Larkin, Administrative Trademark Judge:

PTM Guard, SIA¹ seeks registration on the Principal Register of the claimed
trademark and service mark shown below

¹ The original applicant was Prokapital Management, SIA, a Latvian limited liability company. On November 19, 2020, ownership of the underlying International Registration discussed below was changed to Pranamat Holding, SIA, and on April 29, 2021, after the appeal was instituted, Pranamat Holding, SIA filed a name change to PTM Guard, SIA. We will refer to all three companies as “Applicant.”



for the following goods and services:

Acupressure mats; massage apparatus and instruments; foot massagers; manual massage instruments; back massage apparatus; non-electric massage apparatus; massage apparatus for medical purposes; pillows for therapeutic use, namely, acupressure pillows; acupuncture equipment, instruments and apparatus; non-electric acupuncture instruments; apparatus for the stimulation of acupuncture points; acupuncture needles; acupressure apparatus; apparatus for acupressure therapy; orthopedic cushions; orthopedic foot cushions; air cushions for medical purposes; padded cushions for medical purposes; acupressure pillows in International Class 10;

Pillows; stuffed pillows; cushions; soft furnishings in the nature of cushions; seat cushions in International Class 20;

Carpets; rugs; floor mats and matting in the nature of gymnastic mats and personal exercise mats in International Class 27; and

Retail store services and online retail store services featuring bedding, pillows, cushions, medical instruments, acupressure mats, acupressure pillows, physical therapy equipment, and massage apparatus, appliances and instruments in International Class 35.²

² Application Serial No. 79248407 was filed on September 10, 2018 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f, to extend the protection of International Registration No. 1441500 to the United States. The claimed mark is described as follows: "The mark consists of a three-dimensional configuration comprising a stylized lotus flower." Color is not claimed as a feature of the mark.

The Examining Attorney has refused registration of Applicant's claimed mark on the grounds that (1) as to the goods in Classes 10, 20, and 27, the claimed mark consists of a nondistinctive product design that has not acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f); and (2) as to the services in Class 35, the claimed mark fails to function as a mark under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053, and 1127.

When the Examining Attorney made the refusals final, Applicant appealed and requested reconsideration, which was denied. Applicant and the Examining Attorney have filed multiple briefs on the long and winding road that has led to our door for final decision.³ We affirm both refusals to register.

I. Prosecution and Procedural History, and Record on Appeal⁴

We discuss the prosecution history of the application and the procedural history of the appeal in detail below because they provide necessary background to our resolution of the merits of the refusals.⁵

³ Citations in this opinion to the briefs and other materials in the appeal docket refer to TTABVUE, the Board's online docketing system. See *New Era Cap Co. v. Pro Era, LLC*, 2020 USPQ2d 10596, at *2 n.1 (TTAB 2020). The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear. We discuss the multiple briefs below in our summary of the prosecution history of the application and the procedural history of the appeal. Applicant's operative appeal brief appears at 9 TTABVUE and its supplemental brief appears at 20 TTABVUE. The Examining Attorney's briefs appear at 11 TTABVUE and 22 TTABVUE.

⁴ Citations in this opinion to the application record, including the request for reconsideration and its denial, are either to pages in the Trademark Status and Document Retrieval ("TSDR") database of the United States Patent and Trademark Office ("USPTO"), or to TTABVUE pages with respect to evidence made of record through Applicant's remand request on appeal, discussed below.

⁵ In something of an understatement, the Examining Attorney notes in the final brief that "[t]here have been several Office actions over a period of multiple years in this case." 20

As noted above, Prokapital Management, SIA filed the involved application on December 27, 2018 to extend the protection of its International Registration No. 1441500 to the United States. The Examining Attorney issued an Office Action in which he requested Applicant to clarify whether it was seeking registration of “(1) a two-dimensional design mark that is not trade dress; or (2) a three-dimensional mark that is trade dress for the product design (i.e., the configuration or shape of the goods themselves), product packaging (i.e., the container in which the goods are sold), or a specific design feature of the product design or packaging.”⁶ The Examining Attorney also requested an accompanying amendment to the description of the claimed mark, and amendments to the identifications of goods.⁷ Applicant responded to the Office Action by amending its identifications of goods and by describing its claimed mark as consisting “of a rounded hexagonal design with several bottle-shaped protrusions sprouting up along the exterior edge and throughout the interior of the design.”⁸

The Examining Attorney issued an Office Action in which he accepted Applicant’s amendments to its identification of goods, continued and maintained the request for a description of the claimed mark, issued a refusal to register as to Classes 10, 20, and 27 on the ground that the “applied-for mark consists of a nondistinctive product

TTABVUE 8 n.2. “We acknowledge the unusual and extensive prosecution history of this application, which includes [eight] Office Actions,” but “while the USPTO strives for efficiency in the examination of applications, it is more important that examination be correct than swift.” *In re Larian*, 2022 USPQ2d 290, at *2 n.3 (TTAB 2022).

⁶ January 15, 2019 Office Action at TSDR 1.

⁷ *Id.*

⁸ April 18, 2019 Response to Office Action at TSDR 1.

design or nondistinctive features of a product design that is not registrable on the Principal Register without sufficient proof of acquired distinctiveness,”⁹ issued a refusal to register as to Class 35 on the ground that the applied-for mark “does not function as a service mark to identify and distinguish applicant’s services from those of others and to indicate the source of applicant’s services,”¹⁰ and issued requests for information pursuant to Rule 2.61(b) of the Trademark Rules of Practice, 37 C.F.R. § 2.61(b), regarding the mark and goods, and the function of the goods.¹¹

Applicant responded to the Office Action by stating that the “refusals are both premature and inappropriate,”¹² presumably because the application was filed pursuant to Section 66(a). In response to the Examining Attorney’s requests for information, Applicant stated that the “goods of the mark are specified within the application and the functions are apparent.”¹³

The Examining Attorney issued a subsequent non-final Office Action in which he stated that Applicant had responded to the prior Office Action “by providing insufficient and incomplete responses to the request for information,”¹⁴ and continued and maintained the previous refusals to register.¹⁵ He also issued a specific set of

⁹ May 8, 2019 Office Action at TSDR 1.

¹⁰ *Id.* The Examining Attorney referred to a specimen of use, but because this is a Section 66(a) application, there was no specimen of record.

¹¹ *Id.*

¹² July 19, 2019 Response to Office Action at TSDR 1.

¹³ *Id.*

¹⁴ August 7, 2019 Office Action at TSDR 1.

¹⁵ *Id.*

requests for information under Trademark Rule 2.61(b) regarding Applicant's use of the mark anywhere in the world, sale of any of the goods identified in the application anywhere in the world, and offering of the services identified in the application anywhere in the world.¹⁶ Applicant's response to this Office Action was perfunctory, as it did not address any of the issues raised by the Examining Attorney. It stated merely that the "application is for a two-dimensional mark which Applicant intends to use as a source indicator (on a hang-tag, product packaging or similar)."¹⁷

The Examining Attorney issued another non-final Office Action in which he again stated that Applicant "provid[ed] insufficient and incomplete responses to the request for information."¹⁸ He withdrew the nondistinctive product design refusal, but continued and maintained the information requirement and failure-to-function refusal, and issued a new refusal that the claimed purported two-dimensional mark was merely descriptive of the identified goods under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), because a "picture or design that consists merely of an illustration of the goods, or of an article that is an important feature or characteristic of the goods and services is merely descriptive . . . the same as merely descriptive wording."¹⁹ The Examining Attorney made of record Internet webpages that he claimed show that a "rounded design with several bottle-shaped protrusions merely depicts an important feature or characteristic of acupuncture mats, acupressure

¹⁶ *Id.*

¹⁷ August 9, 2019 Response to Office Action at TSDR 1.

¹⁸ September 9, 2019 Office Action at TSDR 1.

¹⁹ *Id.*

pillows, floor mats, and the retail sale of these products.”²⁰ The Examining Attorney also issued a new failure-to-function refusal.²¹

Applicant responded to this Office Action by stating that its claimed mark consists of “a three-dimensional configuration comprising a stylized lotus flower,”²² and by arguing that its claimed mark, as so described, had acquired distinctiveness.²³ Applicant made of record the declaration of Vladimirs Grigorenko,²⁴ who identified himself as a Member of Prokapital Management, SIA, First V. Grigorenko Decl. ¶ 1,²⁵ and purported Exhibits A-J thereto.²⁶

The Examining Attorney responded by reasserting the refusal based on nondistinctive product design and rejecting Applicant’s claim of acquired distinctiveness under Section 2(f).²⁷ He also maintained and continued the failure-to-function refusal and the refusal based on the earlier requests for information.²⁸ He

²⁰ *Id.* at TSDR 1-13.

²¹ *Id.* at TSDR 1.

²² March 9, 2020 Response to Office Action at TSDR 1.

²³ *Id.*

²⁴ *Id.* at TSDR 2-72. As discussed below, Applicant filed two declarations of Vladimirs Grigorenko, both of which were executed on March 6, 2020, and a declaration of Deniss Grigorenko, which was executed on April 23, 2021.

²⁵ In his second declaration, Vladimirs Grigorenko identified himself as a “Member of the Board of Prokapital Management, SIA.” Second V. Grigorenko Decl. ¶ 1.

²⁶ Although Applicant used exhibit letter designations in the bodies of the three declarations, we could not locate corresponding letters on the hundreds of pages of attachments to the three declarations. This made the review of the attachments unnecessarily difficult.

²⁷ March 31, 2020 Office Action at TSDR 1.

²⁸ *Id.*

made of record Internet webpages that he claimed show that “the applied-for mark is highly nondistinctive of applicant’s goods.”²⁹

Applicant responded to the Office Action by arguing that its claimed mark was not functional within the meaning of Section 2(e)(5) of the Trademark Act, a position not asserted by the Examining Attorney.³⁰ Applicant also argued that its acquired distinctiveness showing was sufficient.³¹ Applicant made of record a copy of its U.S. Design Patent No. D879,314 for the ornamental design for a massage appliance,³² and the second declaration of Vladimirs Grigorenko containing some modifications and some different exhibits and exhibit designations from his first declaration.³³

The Examining Attorney then issued an Office Action making final the refusals that the claimed trademark was nondistinctive product design that had not acquired distinctiveness for the goods in Classes 10, 20, and 27 and that the claimed service mark failed to function as a mark for the services in Class 35.³⁴ The Examining Attorney made of record Internet webpages that he claimed show that Applicant’s

²⁹ *Id.* at TSDR 1-13.

³⁰ September 30, 2020 Response to Office Action at TSDR 2-19.

³¹ *Id.* at TSDR 19.

³² *Id.* at TSDR 20-39.

³³ *Id.* at TSDR 40-109.

³⁴ October 23, 2020 Final Office Action at TSDR 1. The Examining Attorney again referred to a “specimen,” which was not present in this Section 66(a) application, but there was record evidence of Applicant’s use of the claimed mark in commerce.

claimed trademark was “highly nondistinctive of applicant’s goods,”³⁵ and social media pages regarding Applicant’s goods.³⁶

Applicant appealed and simultaneously filed a Request for Reconsideration with more than 450 pages of arguments and evidence.³⁷ Applicant made of record the declaration of Deniss Grigorenko, who identified himself as “a Member of PTM Guard, SIA (formerly Pranamat Holdings, SIA),” D. Grigorenko Decl. ¶ 1, and purported Exhibits A-J thereto.³⁸ The Deniss Grigorenko declaration is very similar in substance to the two Vladimirs Grigorenko declarations, but it contains some updated figures and what appear to be some additional exhibits and other images.³⁹

The Examining Attorney denied Applicant’s Request for Reconsideration, stating that Applicant’s new evidence was insufficient to show that its claimed trademark had acquired distinctiveness.⁴⁰ The Examining Attorney made of record additional Internet webpages that he claimed show that Applicant’s “use of the mark is far from

³⁵ *Id.* at TSDR 1-23, 27-28.

³⁶ *Id.* at TSDR 24-26.

³⁷ April 23, 2021 Request for Reconsideration at TSDR 1-469.

³⁸ *Id.* at TSDR 16-469.

³⁹ Applicant appears to rely on appeal solely on the Deniss Grigorenko declaration, which it describes as the “Updated Declaration of Acquired Distinctiveness,” 9 TTABVUE 6, but we will also consider the earlier declarations of Vladimirs Grigorenko to the extent that they are probative on Applicant’s acquired distinctiveness claim. We will cite the three declarations by paragraph number (e.g., “D. Grigorenko Decl. ¶ 4”) and TSDR pages (e.g., “April 23, 2021 Request for Reconsideration at TSDR at 16-17”). In addition to not having visible exhibit designations, many pages of the attachments to the declarations are blank or have a title but no content, or are reproduced numerous times. These features of the declarations made the record unnecessarily large and difficult to review. “A larger record is not necessarily a better record,” *Sheetz of Del., Inc. v. Doctor’s Assocs. Inc.*, 108 USPQ2d 1341, 1344 n.5 (TTAB 2013), and a larger record is certainly not better when it is the result of sloppiness and redundancy.

⁴⁰ May 21, 2021 Denial of Request for Reconsideration at TSDR 1.

exclusive and that consumers are accustomed to encountering lotus flower product designs on goods like those identified by applicant.”⁴¹

The appeal was then resumed, 6 TTABVUE 1, and Applicant filed its appeal brief. 7 TTABVUE. Applicant attached to its appeal brief more than 1,600 pages of materials, including the three declarations and attachments. *Id.* at 40-1,689. The Board rejected Applicant’s brief on the ground that it exceeded the applicable page limits, 8 TTABVUE 1-2, and Applicant was granted 15 days to file a conforming brief. *Id.* at 2. The body of Applicant’s “Updated Appeal Brief” was shorter, 9 TTABVUE 3-18, but Applicant still attached more than 1,600 pages of materials to it. *Id.* at 19-1,691.⁴²

In his brief, the Examining Attorney objected to consideration of Applicant’s “Updated Appeal Brief” on the ground that it “merely moved content from the body of the original brief to an exhibit in an attempt to circumvent the page limitations set by the Board.” 11 TTABVUE 5. He argued that “[a] comparison of applicant’s July 26, 2021 brief and August 11, 2021 ‘updated brief’ indicates that applicant merely took the content on pages 5-26 of its original brief and repurposed it as an exhibit (namely,

⁴¹ *Id.* at TSDR 1-30.

⁴² As discussed above, Applicant attached numerous materials to all of its briefs. The Board strongly discourages this practice. “Parties to Board cases occasionally seem to be under the impression that attaching previously-filed evidence to a brief and citing to the attachments, rather than to the original submission is a courtesy or a convenience to the Board. It is neither. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether attachments to briefs are properly of record, citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during the prosecution of the application, requiring more time and effort than would have been necessary if citations directly to the prosecution history were provided.” *In re Michalko*, 110 USPQ2d 1949, 1950-51 (TTAB 2014).

‘Exhibit A’) of its ‘updated brief.’” *Id.* at 6 (citing 7 TTABVUE 7-28; 9 TTABVUE 19-41).⁴³

The Examining Attorney also objected to certain of the materials attached to the briefs in the form of “websites labelled ‘Third party use’ in five separate attachments and . . . screenshots from these websites [added] into the body of its brief,” which the Examining Attorney stated appeared “to consist of updated links to websites previously cited by the examining attorney.” *Id.* (citing 7 TTABVUE 7-30, 157-667; 9 TTABVUE 19-41, 726-1237). The Examining Attorney argued that Applicant

is attempting to enter into the record new screenshots and images from websites properly introduced into evidence by the examining attorney during prosecution primarily for the purpose of showing that some of the links are now inactive and also for the purpose of arguing that some of the lotus flower configurations in the evidence are different than applicant’s lotus flower configuration.

Id. (citing 7 TTABVUE 7-30; 9 TTABVUE 19-41). The Examining Attorney concluded that “the attachments labelled ‘Third party use’ added as exhibits to applicant’s briefs as well as the screenshots from the webpages in these attachments that appear in the body of the original brief constitute evidence that has been untimely submitted after appeal and should not be considered by the Board.” *Id.*

Finally, with respect to the attachments to Applicant’s briefs generally, “[t]o the extent that these attachments comprise or contain evidence not previously made of

⁴³ We overrule the Examining Attorney’s objections to our consideration of Applicant’s “Updated Appeal Brief” to the extent that they are directed to the body of the brief, and we will exercise our discretion to consider the arguments in the brief notwithstanding any non-conformity of the body of the brief to the applicable rules. *See Hole in 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *2 (TTAB 2020). We will refer to this “updated” brief simply as Applicant’s “appeal brief.” We address the attachments to the appeal brief below.

record, the [E]xamining [A]ttorney object[ed] to the consideration on the basis that the exhibits constitute evidence that has been untimely submitted.” *Id.* at 8. The Examining Attorney made his arguments “in the alternative for the purpose of addressing arguments made in applicant’s briefs in the event that the Board decides to consider one of the briefs.” *Id.* at 6 n.3.

Applicant responded to the Examining Attorney’s objections to Applicant’s briefs in a filing captioned “Applicant’s Reply To Examining Attorney’s Appeal Brief With Request To Suspend The Appeal And Remand Application For Further Examination,”⁴⁴ in which filing Applicant argued that its “Updated Appeal Brief” was within the applicable page limitations, 12 TTABVUE 3-5, and that the “new” evidence objected to by the Examining Attorney was simply a collection of updated extracts from webpages made of record by the Examining Attorney during prosecution that were intended to show that the “Examining Attorney’s extracts should not be considered because, among other reasons, 23 URLs provided by the examining attorney are no longer resolves [sic] to an active webpage and have no probative value,” *id.* at 5, or to show a clear image of the massage element in the websites made of record by the Examining Attorney. *Id.* at 6. Applicant also requested “to make current links to websites previously cited by the examining attorney of record and remand the application to the Examining Attorney to review current links to websites previously cited in refusals referencing use of various massage elements by third

⁴⁴ In its “Reply” brief, “Applicant respond[ed] to evidentiary issues listed in [the] Examining Attorney’s Appeal Brief,” 12 TTABVUE 2, and did not directly address the merits of the refusal.

parties and consider their applicability” with respect to the “attachments labelled ‘Third Party Use’ and ‘Exhibit A’ submitted with Applicant’s Updated Brief.” *Id.* at 6-543.

The Board granted Applicant’s request to remand and suspended the appeal to allow the Examining Attorney to review the new evidence. 12 TTABVUE 1. On remand, the Examining Attorney found that Applicant’s evidence regarding the unavailability of certain links was unpersuasive because “the transient nature of the internet makes the fact that webpages may have changed over a three year period of little probative value” and that Applicant’s “added evidence does not alter the examining attorney’s determination that applicant has presented insufficient affirmative evidence to meet its burden of showing acquired distinctiveness.”⁴⁵ The Examining Attorney made of record what he described as additional Internet evidence that “further shows that lotus flower configurations remain ubiquitous in the marketplace.”⁴⁶

The Board then resumed the appeal and granted Applicant 60 days in which to file its appeal brief. 17 TTABVUE 1. Applicant then filed “Applicant’s Motion To Rule On The Issue On A Page Limit Excess In Applicant’s Prior Appeal Brief And/Or Motion For Leave To Exceed Page Limit For Brief On Case,” 18 TTABVUE 1, in which Applicant asked the Board to rule that a 26-page table of links in Applicant’s prior briefs “with objections as to why such extracts must be disregarded by the Board,” *id.*

⁴⁵ December 13, 2021 Denial of Request for Reconsideration at TSDR 1.

⁴⁶ *Id.* at TSDR 1-49.

at 2, would not be counted toward the 25-page limit on Applicant's appeal brief, *id.* at 3, or, alternatively, to grant Applicant leave to exceed the 25-page limit. *Id.* at 4.

The Board issued an order granting Applicant 30 days in which to file a supplemental brief "limited to the new issues and evidence raised on remand," and denying Applicant's request to exceed the 25-page limit "[g]iven the limited issues allowed in the supplemental brief. . . ." 19 TTABVUE 1-2. In response, Applicant filed a supplemental brief whose body was within the 25-page limit, 20 TTABVUE 2-15, but which had attached to it numerous additional webpages accessed on February 22, 2022. *Id.* at 16-101. The Examining Attorney then filed a brief addressed to the new issues and evidence raised on remand. 22 TTABVUE 1-9.

II. Evidentiary Issues

Before turning to the merits of the refusals, we must address evidentiary issues raised by Applicant in its briefs.

In its appeal brief, Applicant argues that "out of extracts from 60 website pages provided by the examining Attorney" during prosecution, "23 are currently inactive or have no reference to any relevant products at all." 9 TTABVUE 8. Exhibit A to Applicant's appeal brief was a table addressing the status of the 60 webpages submitted by the Examining Attorney during prosecution. *Id.* at 9-31. Applicant "provided extracts from these 23 pages and assert[ed] that they have no probative value." *Id.* at 8.

In its supplemental brief, Applicant argues that on remand the Examining Attorney "submitted extracts from 48 websites" and that the Examining Attorney

“may not use the remand in order to submit evidence that is not the subject of the remand request.” 20 TTABVUE 3 (citing TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section 1209.04 and *In re Hughes Furniture Indus. Inc.*, 114 USPQ2d 1134, 1136 (TTAB 2015)). Applicant argues that its remand request “was expressly limited to ‘Exhibit A’ submitted with Applicant’s August 11, 2021 Brief,” *id.*, and that the Examining Attorney’s denial of Applicant’s request for reconsideration on remand “contains extracts from multiple websites, which previously were not submitted by the examining attorney.” *Id.* at 4. According to Applicant, “[s]ince the examining attorney did not file a separate request for remand, and such evidence was not within the scope of the request for remand, the Board should disregard such additional evidence.” *Id.*

Applicant argues in the alternative that the new webpages submitted by the Examining Attorney “provide very little – if any- probative value for the purposes of determining [the] scope of third parties’ use of Applicant’s mark . . . as a message element for covered goods.” *Id.* Applicant provides a table of the webpages “showing extracts of message elements presented on the websites and Applicant’s short comments,” *id.* at 5-12, as well as “extracts from all these URLs submitted by the Examining Attorney for the Board to review.” *Id.* at 5. Applicant argues that 23 of the 48 webpages submitted by the Examining Attorney “are currently inactive or have no reference to any relevant products at all” based on extracts from the 23 pages attached to the supplemental brief. *Id.* at 12. Applicant further argues that out of the 25 remaining webpages, only four were previously made of record by the Examining

Attorney, *id.*, and that the other 21 should be deemed “new” evidence and disregarded by the Board. *Id.*⁴⁷

The Examining Attorney responds in his supplemental brief that the “issues and evidence raised on remand and, consequently, the scope of the supplemental briefing allowed in the Board’s January 24, 2022 order are limited to a narrow issue relevant to applicant’s claim that its lotus flower configuration mark has acquired distinctiveness under Section 2(f) of the Trademark Act.” 22 TTABVUE 1. The Examining Attorney argues that after considering the new evidence submitted by Applicant on remand, he attached “48 examples of third party lotus flower configurations available online as of December 13, 2021,” *id.* at 3, the date on which the Examining Attorney rejected the evidence submitted by Applicant on remand.

The Examining Attorney responds to Applicant’s argument and evidence in its supplemental brief “that some links to website screenshots provided by the examining attorney throughout prosecution are now inactive” by arguing that

the Board has long acknowledged the transitory nature of internet websites and that addresses or hyperlinks may be modified or deleted at a later date without notification. . . This is precisely the reason why Examining Attorneys are required to provide complete information as to the date the evidence was published or accessed from the Internet, and its source (e.g., the complete URL address of the website), and attach this evidence to the Office action. . . Thus, without any evidence to the contrary, the Internet printouts submitted by the Examining Attorney

⁴⁷ Applicant also objects specifically to two of the webpages because they are from Amazon UK, 20 TTABVUE 13, and generally to the “overwhelming majority of the message elements” because they are “strikingly different from Applicant’s Mark.” *Id.* at 12. We will address these arguments below in our discussion of Applicant’s claim of substantially exclusive use of its claimed trademark.

demonstrate that the submitted website pages were in existence at the time they were accessed and contained the information shown in the printouts.

Id. at 4 (citations and quotation marks omitted).

The Examining Attorney cites *In re Dakar*, Serial No. 87609180 (TTAB Sept. 27, 2019), a non-precedential decision,⁴⁸ in support of his argument that because the websites made of record during prosecution were in existence at the time of their submission, they should be considered by the Board even if they were inactive at the time of the appeal. 22 TTABVUE 4-5. According to the Examining Attorney, “Applicant has not contended and cannot correctly contend that the webpages submitted by the examining attorney during prosecution never existed” and “those websites existed on the internet at the URL provided by the examining attorney on the dates provided” and “the lotus flower configurations shown on those websites were actually visible to consumers during a time that is relevant to applicant's claim that it was making substantially ‘exclusive’ use of the lotus flower configuration in commerce.” *Id.* at 5.

With respect to the timeliness of the evidence made of record by the Examining Attorney on remand, he argues that

the remand request and the Board’s order remanding the case to the examining attorney essentially asked the examining attorney to assess the Section 2(f) determination--specifically the examining attorney’s determination that the mark is highly nondistinctive--in

⁴⁸ “Non-precedential decisions are not binding on the Board, but may be cited to and considered for whatever persuasive value they may hold.” *In re Fiat Grp. Mktg. & Corp. Commc’ns S.P.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014) (citing *In re Procter & Gamble Co.*, 105 USPQ2d 1119, 1120-21 (TTAB 2012)). As discussed below, the *Dakar* case does not support the Examining Attorney’s position.

light of evidence that previously submitted websites showing third party lotus flower configurations are no longer active. Upon reevaluating the degree of nondistinctiveness, the examining attorney discovered that, despite the fact that previous websites showing third party use of the lotus configuration mark are inactive, several other websites showed third parties offering goods featuring highly similar lotus flower configurations in commerce as of December 13, 2021. This evidence is directly relevant to applicant's arguments that the degree of nondistinctiveness of the mark, which applicant challenged on remand by showing the inactive status of websites previously cited during prosecution. Further, this evidence is within the scope of the Board's order that the case be remanded so the examining attorney may consider the new evidence proffered by applicant.

Id. at 6.

The Examining Attorney further argues that "all the evidence submitted by the examining attorney on remand shows third parties using lotus flower acupressure configurations that are flower-shaped and contain petal-like protrusions encircling the center in a manner highly similar to applicant's lotus flower configuration," *id.* at 6-7, and that the evidence "supports a conclusion that the lotus flower configuration is highly non-distinctive and, as such because the lotus flower configuration is so highly non-distinctive, the applicant has not met its burden of acquired distinctiveness under Trademark Section 2(f)" of showing that "the relevant public understands the primary significance of the mark as identifying the source of a product or service rather than the product or service itself." *Id.* at 7.

We turn first to Applicant's arguments that the Board should not consider websites made of record during prosecution that were inactive, or did not show the referenced products, as of the time of the appeal. In *Dakar*, the Board overruled the

Applicant's objection to webpages made of record during prosecution that the Applicant claimed for the first time in her appeal brief were no longer in existence. 12 TTABVUE 2-3 (Serial No. 87609180). The Board noted, however, that "Applicant did not submit evidence to support her assertion that the websites are no longer in existence, nor did Applicant file a request for remand to submit any such evidence." *Id.* The Board held that "without any evidence to the contrary, the Internet printouts submitted by the Examining Attorney demonstrate that the submitted website pages were in existence at the time they were accessed and contained the information shown in the printouts." *Id.* at 3.

Here, unlike in *Dakar*, Applicant requested a remand to the Examining Attorney to consider evidence establishing the inactivity or altered nature, as of the time of the request, of certain websites made of record by the Examining Attorney during prosecution. 12 TTABVUE 2-8, 9-31. The Examining Attorney submitted pages from 60 websites during prosecution. Applicant claimed in Exhibit A to its request for remand that eight links to pages on the website at amazon.com, *id.* at 9, 15, 16, 24, 25, 26, 27, and 28, one link to a page on the website at cvs.com, *id.* at 11, and one link to a page on the website at walmart.com, *id.* at 21, were inactive, and that eight other websites or webpages were inactive. *Id.* at 15, 16 (two pages), 17 (two pages), and 18 (three pages). Applicant claimed that no relevant products were found on four other active websites. *Id.* at 13, 15, 17-18, and 21.⁴⁹

⁴⁹ Applicant claimed that products were removed from one of the websites after Applicant sent a cease-and-desist letter to the owner of the website, 12 TTABVUE 21, and that Applicant also sent a cease-and-desist letter to the owner of another website. *Id.* at 19. Neither of the Messrs. Grigorenko testified about Applicant's enforcement of its claimed

In *In re Canine Caviar Pet Foods, Inc.*, 126 USPQ2d 1590 (TTAB 2018), the Board excluded certain “cached” webpages submitted by the examining attorney where the applicant provided evidence that the referenced sites was no longer active. *Id.* at 1594-95. The Board held that “although the Examining Attorney’s evidence did properly include a URL and date, due to Applicant’s objections that certain sites are not active, we find that such evidence is not probative.” *Id.* at 1595. Here, as in *Canine Caviar*, Applicant provided evidence that certain websites referenced by the Examining Attorney are no longer active, and we will not consider the third-party products displayed on those inactive websites. 12 TTABVUE 15 (twixfit.com), 16 (facebook.com page for House of Kalm and earthgears.com), 17 (inspireecoware.com and sacredweapon.com), and 18 (rubyinsight.com, beanultra.com, and GoRelax).

The inactive links to pages on the websites of Amazon, CVS, and Walmart are another matter. The Board has noted the “transitory nature of the Internet.” *Safer Inc. v. OMS Invs. Inc.* 94 USPQ2d 1031, 1039 (TTAB 2010). Because the websites of these companies offer thousands of products that change over time, and Applicant has not shown that the referenced webpages did not exist, or did not display the products shown on the webpages, when they were accessed and made of record, we

rights or the claimed removal of challenged products from the marketplace. As a result, Applicant’s assertions regarding enforcement “are unsupported by sworn statements or other evidence, and [a]ttorney argument is no substitute for evidence.” *In re OEP Enters., Inc.*, 2019 USPQ2d 309323, at *15 (TTAB 2019) (quoting *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018)).

will consider these webpages for whatever probative value they may have.⁵⁰ For similar reasons, we will also consider the prior webpages from currently active sites that showed relevant products when the Examining Attorney made them of record, but showed different products when Applicant later accessed them.

We turn next to Applicant's objection to consideration of the 48 websites made of record by the Examining Attorney on remand. As Applicant notes, the TBMP cites *Hughes Furniture* for the proposition that on a remand requested by the applicant, the "examining attorney may only consider the matter for which the application has been remanded" and "may not use the remand in order to submit evidence in connection with a refusal or requirement that is not the subject of the remand request." TBMP § 1209.04. In *Hughes Furniture*, which involved a likelihood of confusion refusal under Section 2(d) of the Trademark Act and a disclaimer refusal, the applicant filed an appeal brief together with a request to remand to enter the required disclaimer of the word MOTION in the composite mark shown below:



The Board granted the request to remand, which "was intended simply to comply with the disclaimer requirement and did not constitute an attempt to overcome the Section 2(d) refusal." *Hughes Furniture*, 114 USPQ2d at 1135.

⁵⁰ The pages from amazon.com are particularly relevant because Applicant has also sold its goods on amazon.com. D. Grigorenko Decl. ¶ 4k (April 23, 2021 Request for Reconsideration at TSDR 24).

Following the remand in *Hughes Furniture*, the “Examining Attorney deemed Applicant’s proposed disclaimer acceptable and entered the disclaimer in the application,” but “mistakenly treated Applicant’s request for remand as a request for reconsideration, and used the occasion to submit additional evidence obtained from the Internet in further support of the likelihood of confusion refusal.” *Id.* The Board held that “it was impermissible for the Examining Attorney, upon receipt of the request for remand and acceptance of the amendment, to submit evidence in support of the likelihood of confusion refusal since the refusal was not the subject of Applicant’s request for remand,” *id.* at 1136, because “the request for remand was only for the purpose of the Examining Attorney’s considering the disclaimer offered by Applicant,” and “therefore the Examining Attorney was limited to accepting or rejecting this disclaimer, and submitting evidence relating to the disclaimer.” *Id.* The Board held that the examining attorney should have requested remand “for the purpose of submitting additional evidence in support of the likelihood of confusion refusal.” *Id.*

The remand request here sought to “make current links to websites previously cited by the examining attorney of record” to allow the Examining Attorney “to review current links to websites previously cited in refusals referencing use of various message elements by third parties and consider their applicability.” 12 TTABVUE 6. The Board’s order granting the request stated simply that “Applicant seeks remand so that the Trademark Examining Attorney may consider the new evidence.” 13 TTABVUE 1.

The Examining Attorney's Office Action on remand was captioned "Request for Reconsideration After Final Office Action Denied." The Examining Attorney argued that the "transient nature of the internet makes the fact that webpages may have changed over a three year period of little probative value," and "[f]urther, the currently attached internet evidence further shows that lotus flower configurations remain ubiquitous in the marketplace."⁵¹ The Examining Attorney also stated that Applicant's "added evidence does not alter the examining attorney's determination that applicant has presented insufficient affirmative evidence to meet its burden of showing acquired distinctiveness. Therefore, the request for reconsideration is DENIED."⁵²

The "fit" here between the purpose of the remand and the Examining Attorney's response to it is much tighter than it was in *Hughes Furniture*, in which the examining attorney used a remand designed to allow her to consider entry of a disclaimer offered to resolve the disclaimer refusal as a vehicle to augment her showing in support of the separate likelihood of confusion refusal. Nevertheless, we find that the Examining Attorney went beyond simply examining Applicant's evidence regarding the status of some of the websites that the Examining Attorney made of record during prosecution by making 48 new website screenshots of record.

⁵¹ December 13, 2021 Denial of Request for Reconsideration After Final Office Action at TSDR 1. The Examining Attorney stated in his second brief that the 48 website screenshots show "that not only were lotus flower configurations highly similar to applicant's configuration pervasive online throughout prosecution, but also that such closely similar lotus flower configurations remained ubiquitous in online commerce well into 2021." 22 TTABVUE 6.

⁵² *Id.*

We must decide whether to exclude the “new” websites from the record where Applicant addressed each of them in its supplemental brief and attached evidence directed to their current status, 20 TTABVUE 5-12, 16-101, and the Examining Attorney stated in his second brief that he had “no objection to the inclusion of the evidence added to applicant’s supplemental brief and [saw] no need for another remand to consider the narrow issue of the degree of nondistinctiveness.” 22 TTABVUE 8-9 n. 6.

We conclude that the websites should be excluded. On remand, it would have been appropriate for the Examining Attorney to have made of record any purportedly inactive webpages that were, in fact, active at the time, but if he wished to make of record entirely new websites to support the refusals, he should have requested remand himself, which “would also have to include a showing of ‘good cause’ (i.e., a satisfactory explanation as to why the evidence was not made of record prior to appeal), along with the additional evidence sought to be introduced.” *Hughes Furniture*, 114 USPQ2d at 1136. Applicant’s “objection is sustained, and the Examining Attorney’s [new] evidence submitted on [December 13, 2021] is not considered to be in the record and, accordingly, has been given no consideration.” *Id.*⁵³

⁵³ Because we have excluded the new webpages made of record by the Examining Attorney on remand, we have not considered Applicant’s discussion of them in its supplemental brief. 20 TTABVUE 5-12. Applicant acknowledges that four of the webpages were previously made of record by the Examining Attorney, and we have considered the original versions of those webpages for whatever probative value they may have.

III. Analysis of Refusal Based on Nondistinctive Product Design and the Insufficiency of Applicant’s Evidence of Acquired Distinctiveness

With respect to the goods in Classes 10, 20, and 27 in the application, Applicant’s self-described “three-dimensional configuration comprising a stylized lotus flower” is a product design trademark. The record shows, as the Examining Attorney accurately puts it, that “the lotus configuration appears in a repeating arrangement on applicant’s goods and each single lotus configuration serves as an acupuncture apparatus which collectively produces a massaging effect when applicant’s goods are in use.” 11 TTABVUE 9.

Applicant correctly acknowledges that a “mark that consists of product design trade dress is not registrable on the Principal Register unless the applicant establishes that the mark has acquired distinctiveness under §2(f).” 9 TTABVUE 6 (citing *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 54 USPQ2d 1065, 1069-70 (2000)). See, e.g., *OEP Enters.*, 2019 USPQ2d 309323, at *16 (“[P]roduct designs can never be inherently distinctive and will always require evidence of acquired distinctiveness or secondary meaning to be registrable as marks”) (quoting *Kohler Co. v. Honda Giken Kogyo K.K.*, 125 USPQ2d 1468, 1503-04 (TTAB 2017)). Accordingly, on the refusal to register Applicant’s claimed trademark for the goods in Classes 10, 20, and 27, the sole issue is whether Applicant’s evidence of acquired distinctiveness under Section 2(f) of the Trademark Act is sufficient to show that

“consumers perceive the design of Applicant’s [goods] as an indicator of source.”
Larian, 2022 USPQ2d 290, at *51.⁵⁴

A. Applicable Law Under Section 2(f)⁵⁵

“Distinctiveness is acquired by ‘substantially exclusive and continuous use’ of the mark in commerce.” *Id.*, at *37 (quoting *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1554 (TTAB 2009)). “[T]he burden of proving a prima facie case of acquired distinctiveness in an ex parte proceeding rests with” the applicant. *In re Dimarzio, Inc.*, 2021 USPQ2d 1191, at *8 (TTAB 2021). *See also In re La. Fish Fry Prods., Ltd.*, 797 F.3d 1335, 116 USPQ2d 1262, 1265 (Fed. Cir. 2015) (citing *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1422 (Fed. Cir. 2005)). Applicant “must show that the primary significance of the product configuration in the minds of consumers is not the product but the source of that product in order to establish acquired distinctiveness.” *Larian*, 2022 USPQ2d 290, at *37 (citing *Stuart Spector Designs*, 227 USPQ2d at 1554).

⁵⁴ In its appeal brief, Applicant argues that the evidence does not show that Applicant’s claimed trademark “is in fact nondistinctive, common or descriptive.” 9 TTABVUE 7. As discussed above, because Applicant’s claimed trademark is product design, it is not inherently distinctive as a matter of law. We interpret Applicant’s argument to be that its claimed trademark has acquired distinctiveness and thus is no longer “nondistinctive” and that third-party uses of similar designs do not render Applicant’s claimed trademark “common or descriptive.”

⁵⁵ As discussed above, Applicant’s application was filed under Section 66(a) of the Trademark Act based on Applicant’s International Registration rather than under Section 1(a) of the Act based on Applicant’s allegation of use of the claimed trademark in commerce. Nevertheless, Applicant may seek registration of its claimed trademark under Section 2(f) on the ground that it has acquired distinctiveness through its use in commerce that may be lawfully regulated by Congress. *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE (“TMEP”) Section 1212.08 (July 2022) and cases cited therein.

“It is axiomatic that ‘the lesser the degree of inherent distinctiveness, the heavier the burden to prove that [a mark] has acquired distinctiveness.’” *Id.*, at *38 (quoting *In re Udor U.S.A. Inc.*, 89 USPQ2d 1978, 1986 (TTAB 2009)). “While there is no fixed rule for the amount of proof necessary to demonstrate acquired distinctiveness, the burden is heavier in this case because it involves product configuration[].” *Id.* (quoting *In re Ennco Display Sys. Inc.*, 56 USPQ2d 1279, 1283-84 (TTAB 2000)); see also *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988) (evidence required to show acquired distinctiveness is directly proportional to the degree of nondistinctiveness of the mark at issue).

“We weigh six interrelated factors to determine whether a proposed mark has acquired secondary meaning:

- (1) Association with a particular source by actual purchasers (typically measured by customer surveys);
- (2) Length, degree, and exclusivity of use;
- (3) Amount and manner of advertising;
- (4) Amount of sales and number of customers;
- (5) Intentional copying; and
- (6) Unsolicited media coverage of the product embodying the mark.”

Larian, 2022 USPQ2d 290, at *38 (citing *Converse, Inc. v. ITC*, 909 F.3d 1110, 128 USPQ2d 1538, 1546 (Fed. Cir. 2018)).⁵⁶ “When the evidence comprises evidence such

⁵⁶ Trademark Rule 2.41(a), 37 C.F.R. § 2.41(a), provides that an applicant may show acquired distinctiveness through three types of evidence: (1) ownership of prior Principal Register registrations of the same mark for the same or similar goods for which registration is sought, (2) five years substantially exclusive and continuous use of the mark in commerce, and (3) “[o]ther evidence.” 37 C.F.R. § 2.41(a)(3). “The *Converse* factors dovetail with Trademark

as the applicant's length and manner of use, it is usually expected that such evidence will be 'supplemented by evidence of the effectiveness of such use to cause the purchasing public to identify the mark with the source of the product.'" *Id.*, at *39 (quoting *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, 422 (Fed. Cir. 1985)).

B. Analysis of the *Converse* Factors

A showing of acquired distinctiveness "need not include all of the[] types of evidence" reflected in the *Converse* factors because the determination of acquired distinctiveness "involves assessing all of the circumstances involving the use of the mark," but "in the context of product design marks, it is imperative that the evidence of acquired distinctiveness 'relate to the promotion and recognition of the specific configuration embodied in the applied-for mark and not to the goods in general.'" *Larian*, 2022 USPQ2d 290, at *39 (quoting *In re Change Wind Corp.*, 123 USPQ2d 1453, 1467 (TTAB 2017) (citations omitted)). *See also In re SnowWizard, Inc.*, 129 USPQ2d 1001, 1005 (TTAB 2018). Applicant does not discuss *Converse*, but we will

Rule 2.41(a)(3), which provides that "[i]n appropriate cases, where the applicant claims that a mark has become distinctive in commerce of the applicant's goods or services, the applicant may, in support of registrability, submit with the application, or in response to a request for evidence or to a refusal to register, verified statements, depositions, or other appropriate evidence showing duration, extent, and nature of the use in commerce and advertising expenditures in connection therewith (identifying types of media and attaching typical advertisements), and verified statements, letters or statements from the trade or public, or both, or other appropriate evidence of distinctiveness.'" *Dimarzio*, 2021 USPQ2d 1191, at * 7 n.15.

consider Applicant's arguments and the record evidence using the *Converse* framework.⁵⁷

In that regard, while Applicant's appeal brief cites a few specific materials in the record, 9 TTABVUE 10-13,⁵⁸ it otherwise asks the Board to search for relevant evidence in a very extensive and disjointed record: "Instead of repeating all of the claims and facts listed in the Declaration, Applicant pleads the Board to carefully review [the] Declaration with over 60 supporting documents." *Id.* at 13. This is unhelpful advocacy. "Judges are not like pigs, hunting for truffles buried in . . . [the record]." *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *14 (TTAB 2022) (quoting *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1803 (TTAB 2018), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021)). While we will, of course, review the entire record, it was incumbent on Applicant and its counsel to point us to all specific materials in the record that support the claims made in Applicant's briefs instead of asking us to "wad[e] through it" to "find something probative." *RxD Media*, 125 USPQ2d at 1803.

⁵⁷ The first *Converse* factor, the association of the claimed trademark with Applicant by actual purchasers, is inapplicable on this record because "Applicant does not present a consumer survey or declarations made by consumers themselves." *Larian*, 2022 USPQ2d 290, at *39. The "record does contain evidence consisting of articles and product reviews, and comments thereto made by consumers," and we will "address this evidence below in the discussion of unsolicited media attention." *Id.*

⁵⁸ As the Examining Attorney notes, however, it is "difficult to discern: (1) which declaration applicant is citing, and (2) where in the application record the examining attorney and the Board can locate the cited evidence." 11 TTABVUE 12.

1. Length, Degree, and Exclusivity of Use of the Claimed Trademark

Applicant argues that its declarations provide “an overwhelming amount of evidence of substantially exclusive use of [its claimed trademark] as a source identifier in [the] US for over 10 years.” 9 TTABVUE 10. Deniss Grigorenko stated that Applicant has used its claimed trademark in U.S. commerce “since at least as early as 2010 in connection with acupressure and massaging devices and related retail services . . . eleven years before the date on which this claim of distinctiveness is being made.”⁵⁹ In its *Larian* decision earlier this year, the Board characterized the applicant’s use of its claimed trademark since 2013 as “moderately long,” *Larian*, 2022 USPQ2d 290, at *39, but cautioned that such use “is not necessarily conclusive or persuasive on the issue of acquired distinctiveness, particularly involving a product design mark.” *Id.* See also *Change Wind*, 123 USPQ2d at 1468 (discussing cases in which various periods of use have been found to be insufficient to show acquired distinctiveness).

With respect to its exclusivity of use, Applicant’s appeal brief argues that “nearly all” of the products shown on the websites made of record by the Examining Attorney “are substantially different from Applicant’s design.” 9 TTABVUE 8. Applicant’s briefs display a number of products whose designs are somewhat different from Applicant’s claimed trademark. *Id.* at 9; 20 TTABVUE 14. Applicant concludes in its appeal brief that it is “predominately and substantially exclusively using [its claimed

⁵⁹ D. Grigorenko Decl. ¶ 2 (April 23, 2021 Request for Reconsideration at TSDR 16).

trademark] as a source identifier and none of the other designs located by the Examining Attorney are even remotely similar to the unique and highly recognizable . . . design” in Applicant’s claimed trademark. 9 TTABVUE 9-10.

In its supplemental brief, Applicant argues that the “fact that over the course of 37 months and 8 refusals, the Examining Attorney managed to locate only several potentially similar designs on the market, demonstrates that [the claimed trademark] has been used as a mark by Applicant almost exclusively.” 20 TTABVUE 13. Applicant again displays what it calls “numerous alternative designs,” *id.*, which it claims show that “Applicant is predominately and substantially exclusively using [the claimed trademark] as a source identifier,” and concludes again that “none of the other designs located by the Examining Attorney are even remotely similar to the unique and highly recognizable . . . design.” *Id.* at 14.

The Examining Attorney argues in his appeal brief that numerous websites in the record show that “massaging apparatus components in the shape of a lotus flower are routinely used as a design element of acupuncture mats, pillows, cushions, and other goods like those identified by applicant.” 11 TTABVUE 10-12 (listing 39 websites). As noted above, we have not considered products shown on the websites at twixfit.com, earthgears.com, inspireecoware.com, sacredweapon.com, rubyinsight.com, and beanultra.com, on the Facebook page for House of Kalm, and on a page showing a GoRelax product, but we display below a representative sample of the numerous products shown on other websites:



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⁶⁰ September 9, 2019 Office Action at TSDR 5-6 (Artree acupressure mat and pillow on amazon.com).

⁶¹ *Id.* at TSDR 7-8 (Dosha acupressure mat at dosha.com).

⁶² March 31, 2020 Office Action at TSDR 5 (Master Smart Gear foot massage mat at manifestedmeditations.com). Text accompanying the product states that it has “been designed with your back in mind using the lotus flower design” and that the “shape of the



lotus is ideal for massaging your back and can direct the petals to that tension spot and apply pressure for that much needed relief.” *Id.*

⁶³ *Id.* at TSDR 8 (ZenGuru acupressure mat and pillow set on amazon.com). These products are described as a “Lotus Spike Mat & Pillow.”

⁶⁴ *Id.* at TSDR 13.

Convenience, Featured Products, Health And Beauty, Popular, Sports Accessories

Yoga Mat Lotus Spike Acupressure Set

★★★★★ (47 customer reviews)

In Stock (Ships Out Within 24 Hours)

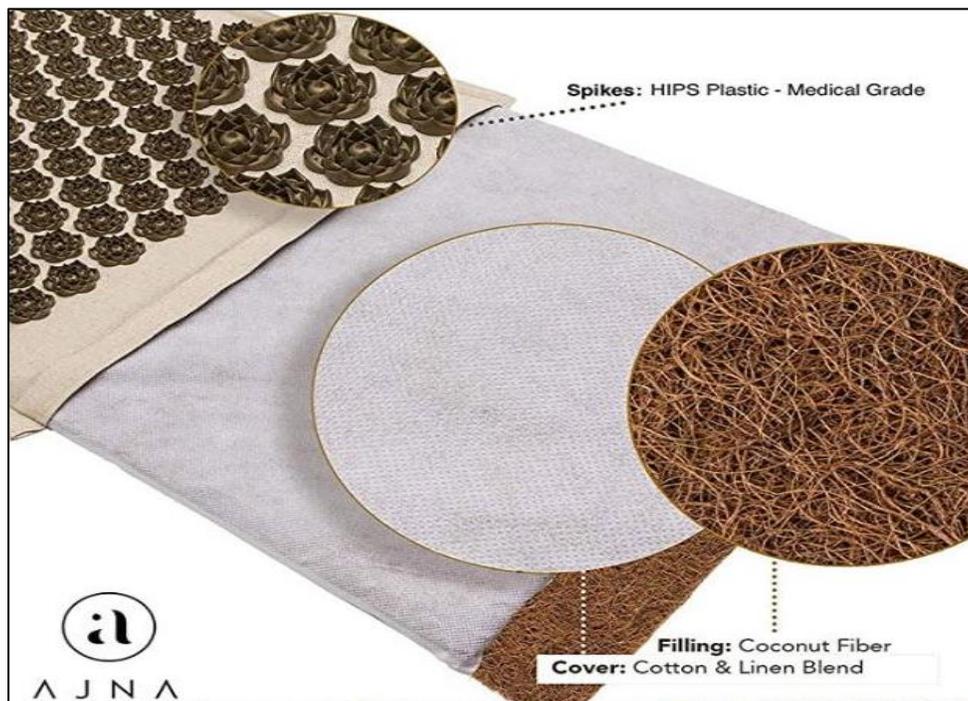
- This Acupressure set will let you relax your mind and body effectively
- It has a lot of health benefits like decreasing stress and improving your blood circulation
- It can help you become healthy, happy, and physically fit
- Material: Cotton, ABS, Nylon, Opp Bag
- Weight: 670g / Size: 40 x 66cm
- Yoga Mat Lotus Spike Acupressure Set Package Includes:
 - 1 x Yoga Mat
 - 1 x Ordinary Spikes Pillow
 - 1 x Free Bag



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Spikes: HIPS Plastic - Medical Grade

Filling: Coconut Fiber
Cover: Cotton & Linen Blend



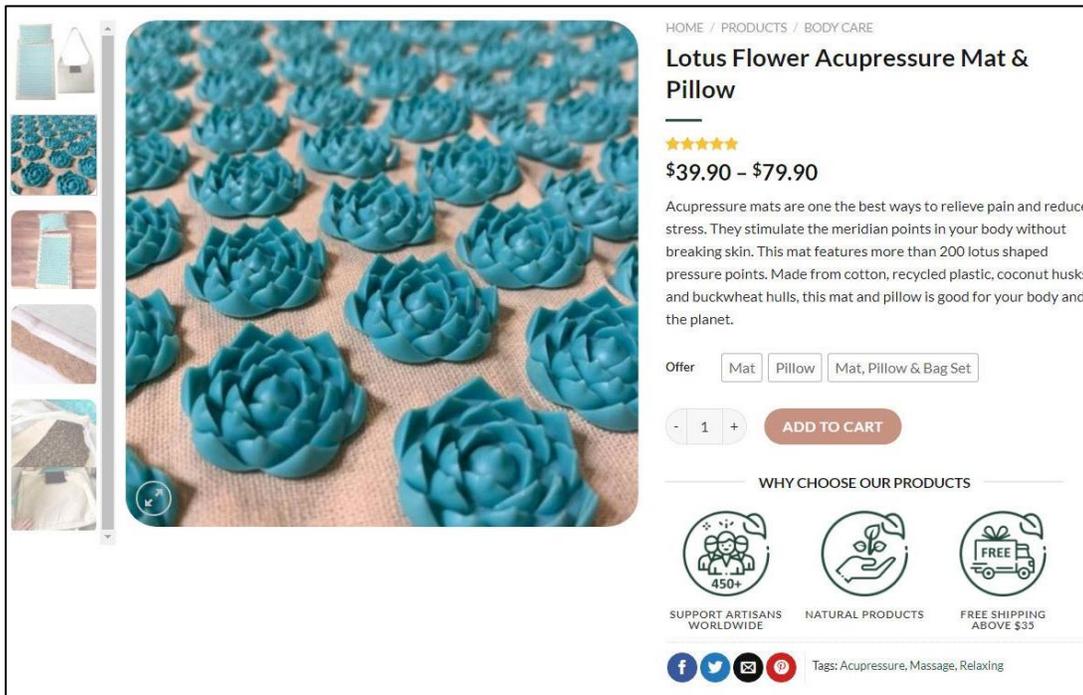
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⁶⁵ October 23, 2020 Final Office Action at TSDR 7 (lcpshop.net).

⁶⁶ *Id.* at TSDR 15 (amazon.com).



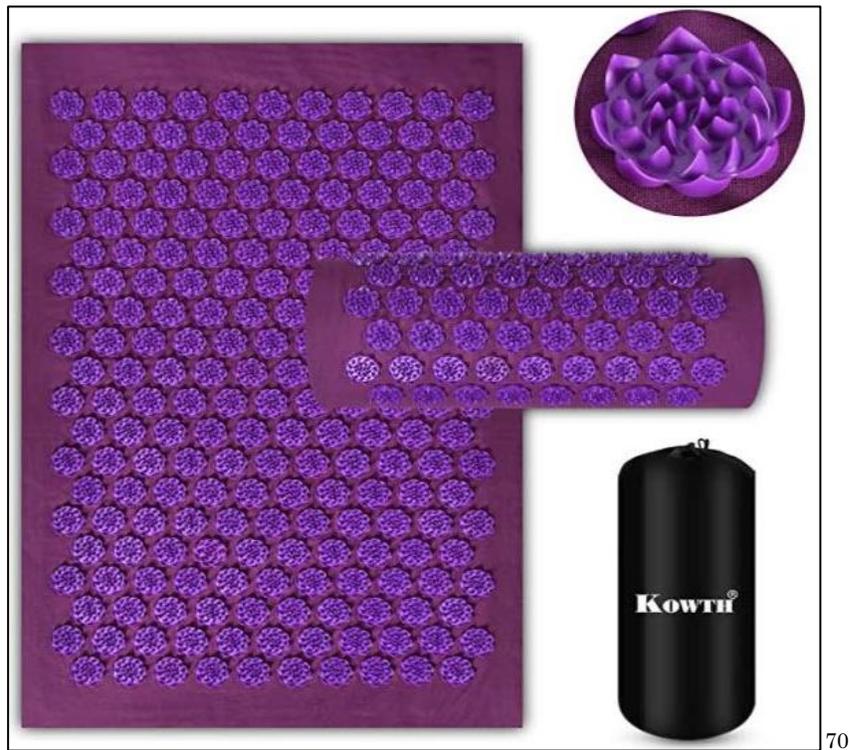
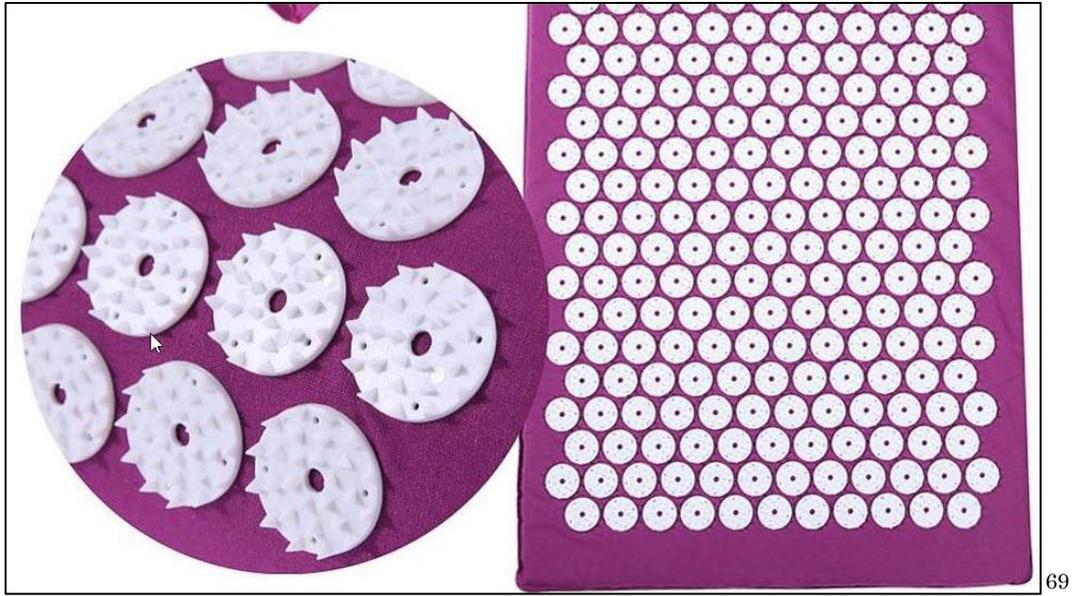
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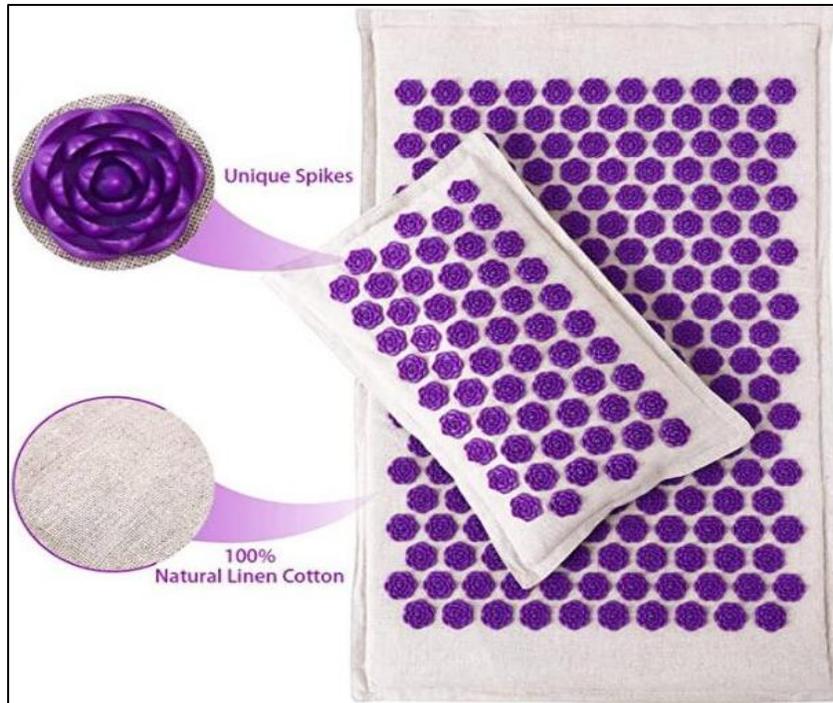
⁶⁷ *Id.* at TSDR 18 (youtube.com).

⁶⁸ *Id.* at TSDR 21 (gardenofalice.com).

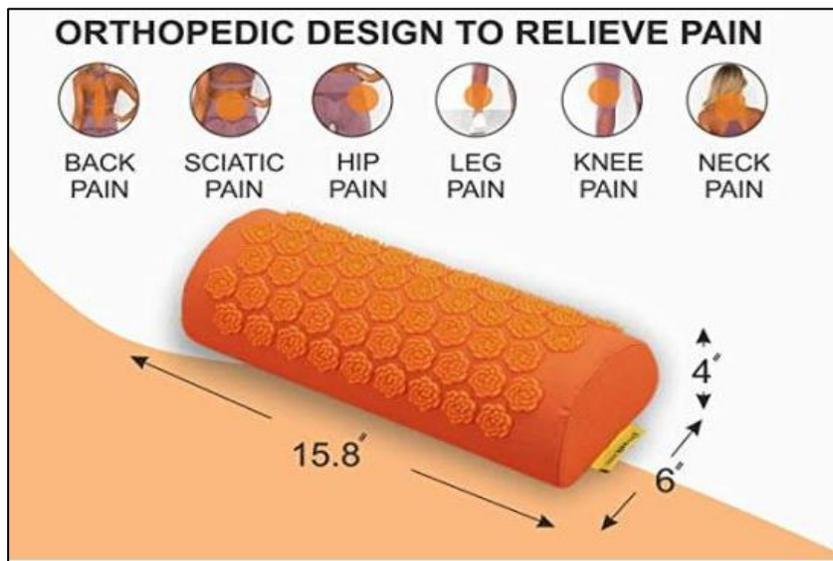


⁶⁹ May 21, 2021 Denial of Request for Reconsideration at TSDR 6 (yourbeautifulspa.com). Text accompanying the product states that “[o]ur mats feature more than 4,500 high-quality acupressure points in the beautiful shape of lotus flowers.” *Id.*

⁷⁰ *Id.* at TSDR 11 (amazon.com). Text accompanying the products touts their “Lotus Shape and Suitable Size.” *Id.*



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⁷¹ *Id.* at TSDR 13 (Mayyosuru acupressure mat and pillow set on amazon.com). Text accompanying the products states that “[o]ur mats feature thousands of high-quality acupressure points in the beautiful shape of lotus flowers.” *Id.*

⁷² *Id.* at TSDR 17 (TimeBeeWell acupressure mat and pillow set on amazon.com). Text accompanying the products states that they “use HIPS lotus-shaped spikes that stimulate your skin, muscles, and body to revitalize your energy levels and create a more balanced, euphoric mood.” *Id.*



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⁷³ *Id.* at TSDR 21 (DDPD 2021 Acupressure Mat Lotus Spike Yoga mat on amazon.com).

⁷⁴ *Id.* at TSDR 26 (Pomnefe Lotus Spike Acupressure Mat Set on amazon.com).

We agree with Applicant that some of the products displayed on webpages in the record embody spike designs that are less similar to Applicant's lotus design than are the designs shown above, but the record shows that there have been a substantial number of mats and pillows embodying lotus designs that are nearly identical in appearance to Applicant's design. In the final analysis, to paraphrase the adage about the perception of beauty, what constitutes a lotus flower design is ultimately in the eye of the beholder, but the record shows that the beholder has frequently been steered toward seeing designs as lotus flowers by the descriptions of many of the competitive products in the record as "lotus" mats and pillows, or as having "lotus" spikes or spikes in the shape of "lotus flowers,"⁷⁵ as well as by the display of individual "flowers." This suggests that there is a recognized category of acupuncture mats and pillows with lotus spikes, and Applicant's products look nearly identical to many other products in that category.⁷⁶

⁷⁵ In addition to the references to lotus flowers shown above, the record includes the use of the "Lotus Acupuncture" trade name by a seller of acupuncture mats and pillows, March 31, 2020 Office Action at TSDR 2, the display of a "lotus Acupuncture Mat and Pillow Set" featuring a "Lotus Shape" and "particular lotus spikes [that] provide 'deeper' relief," October 23, 2020 Final Office Action at TSDR 27, and the display and discussion of an "Acupuncture Mat Pillow Set Lotus Massage Cushion" with "ACU Black Set-White Lotus." *Id.* at TSDR 28.

⁷⁶ Applicant's declarants state that its claimed three-dimensional mark is based on a two-dimensional lotus flower design "with 25 petals each" created by Sergejs Jermoshins, a Latvian artist. First and Second V. Grigorenko Decls. ¶ 4a (March 9, 2020 Response to Office Action at TSDR 2; September 30, 2020 Response to Office Action at TSDR 40-41); D. Grigorenko Decl. ¶ 4a (April 23, 2021 Request for Reconsideration at TSDR 16-17). As shown and discussed below, there are a few mentions on Applicant's website that Applicant's lotus flowers have 25 petals each, but there is nothing in the record to suggest that consumers will distinguish Applicant's claimed trademark from other lotus flower designs because Applicant's flowers have 25 petals each, and the other lotus flower spikes may have a different number.

The third-party uses in the record “defy Applicant’s claim that its use is ‘substantially exclusive’ such that Applicant’s use would support a finding its mark has acquired distinctiveness.” *Larian*, 2022 USPQ2d 290, at *40. “While absolute exclusivity is not required,” *id.*, “the widespread use [and] sale of . . . [lotus] designs similar to Applicant’s applied-for mark by third parties is inconsistent with Applicant’s claim of substantially exclusive use of the design and, ultimately, of acquired distinctiveness.” *Id.*, at *41. *See also Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 940-41 (Fed. Cir. 1984) (“When the record shows that purchasers are confronted with more than one (let alone numerous) independent users of a term or device, an application for registration under Section 2(f) cannot be successful, for distinctiveness on which purchasers may rely is lacking under such circumstances.”). The *Converse* factor regarding the length, degree, and exclusivity of Applicant’s use of its claimed trademark does not support a finding of acquired distinctiveness.

2. Amount and Manner of Advertising

Applicant’s appeal brief does not discuss Applicant’s advertising per se, but the two Vladimirs Grigorenko declarations state that “[s]ince 2010, [Applicant] have [sic] spent over \$135,000 actively advertising [the] Lotus Mark in [the] US through Google AdWords®, Facebook®, YouTube®, Amazon®, Instagram® and other channels,”⁷⁷ while the Deniss Grigorenko declaration states that “[s]ince 2010, [Applicant] have

⁷⁷ First and Second V. Grigorenko Decls. ¶ 4(e) (March 9, 2020 Response to Office Action at TSDR 3; September 30, 2020 Response to Office Action at TSDR 41).

[sic] spent over \$200,000 actively advertising [the] Lotus Mark in [the] US through Google AdWords®, Facebook®, YouTube®, Amazon®, Instagram® and other channels.”⁷⁸ Deniss Grigorenko’s testimony conflicts with Vladimirs Grigorenko’s earlier testimony unless we assume that Applicant’s advertising expenditures between March 6, 2020 and April 23, 2021, a period of slightly more than one year, were nearly half of what Vladimirs Grigorenko testified were expended during the entire previous period between 2010 and March 6, 2020. But even if we accept Deniss Grigorenko’s testimony regarding higher total expenditures between 2010 and 2021, Applicant spent an average of only about \$18,000 on advertising annually during that period. On their face, these figures are miniscule and fall far short of suggesting, by their magnitude alone, that the advertised goods have acquired distinctiveness. *Cf. In re Hikari Sales USA, Inc.*, 2019 USPQ2d 111514, at *15-16 (TTAB 2019) (discussing cases in which various levels of advertising expenditures have been found to be insufficient to establish that word marks have acquired distinctiveness). Applicant also provides no information about how these figures compare to the expenditures of Applicant’s competitors in the United States that might suggest that Applicant’s expenditures are significant despite their tiny size in absolute terms.

The Board has long held that even compelling “advertising figures do not always amount to a finding of acquired distinctiveness.” *OEP Enters.*, 2019 USPQ2d 309323, at *22 (citing *Kohler*, 125 USPQ2d at 1516). “[T]he more important question is how the alleged mark is being used, i.e., in what manner have consumers been exposed to

⁷⁸ D. Grigorenko Decl. ¶ 4(e) (April 23, 2021 Request for Reconsideration at TSDR 17).

the alleged mark so that we can impute consumer association between the configuration and the product producer.” *Id.*, *22-23 (quoting *Kohler*, 125 USPQ2d at 1516).

“When advertisements are submitted as evidence of acquired distinctiveness, they must demonstrate the promotion and recognition of the specific configuration embodied in the applied-for mark and not of the goods in general.” *Id.*, at *23 (quoting *Kohler*, 125 USPQ2d at 1516). “The sort of advertising that can demonstrate that a trade dress has acquired distinctiveness is commonly referred to as ‘look for’ advertising; that is, advertising that directs the consumer to ‘look for’ the particular feature(s) claimed as a trademark.” *Id.* (quoting *Kohler*, 125 USPQ2d at 1516). We will “examine Applicant’s advertising to see whether it encourages consumers or the trade to view the applied-for design as Applicant’s mark.” *Id.*

Applicant’s declarants testified exclusively about Applicant’s advertising on the Internet, including on social media. Vladimirs Grigorenko stated that “[n]early 1,5 million US users visited [Applicant’s] websites pranamateco.com and pranamat.com which prominently displays [sic] [Applicant’s claimed trademark] and primarily advertises [sic] acupuncture and massaging devices displaying [Applicant’s claimed trademark] with over US 750,000 sessions and 1,600,000 pageviews by US users.”⁷⁹ Deniss Grigorenko stated that “[n]early 3,8 million US users (since 28.08.2016) visited [Applicant’s] websites pranamateco.com and pranamat.com which

⁷⁹ First and Second V. Grigorenko Decls. ¶ 4(f) (March 9, 2020 Response to Office Action at TSDR 3; September 30, 2020 Response to Office Action at TSDR 41). The second declaration specifies that “[m]ore than 1 489 278 US users” visited Applicant’s websites.

prominently displays [sic] [Applicant’s claimed trademark] and primarily advertises [sic] acupuncture and massaging devices displaying [Applicant’s claimed trademark] with over US 5,150,000 sessions and nearly 8,000,000 pageviews by US users.”⁸⁰

Both declarants attached extracts from Applicant’s websites and social media pages to their declarations. We reproduce below pertinent portions of several pages:

The screenshot displays the Pranamateco website's product selection interface. At the top, a purple banner reads "Get your Pranamateco ECO" with a "Free Shipping On All Orders!" note. Below this, a "UNIQUE Offer" states that a Pranamateco Micro is free with any order from the E-Shop, with limited quantity. The main section is divided into two steps: "STEP 1: Choose your product" and "STEP 2: Choose your color".

STEP 1: Choose your product

Product	Price
Pranamateco ECO Set (Mat + Pillow)	\$245
Pranamateco ECO Set (Mat + Pillow + Mini) - 10% off	\$360 \$306
Pranamateco ECO Set (Mat + Pillow + Mini + Bag) - 15% off	\$360 \$323
Pranamateco ECO Set (Mat + Pillow + Bag)	\$285
Pranamateco ECO Mat	\$145
Pranamateco ECO Pillow	\$100

STEP 2: Choose your color

Classic colors: [Color swatches] Limited edition: [Color swatches]

Price: **\$ 306** **ADD TO CART**

Size:

Product	Dimensions
Pranamateco ECO	28.7 x 17.7 in (73 x 45 cm)
PranaPillow	13.38 x 17.72 in (34 x 45 cm)
Pranamateco Mini	13.38 x 17.7 in (34 x 45 cm)

Materials:

- Cover: 100% natural linen
- Lotus-Flower massagers: HiPS plastic. Safe for health also used in food packaging and toys.
- Pillow Filler: 100% natural buckwheat hulls
- Filler cover: 100% cotton
- Pillow: 95 Lotus-Flower massagers with 25 petals each
- Mini: 95 Lotus-Flower massagers with 25 petals each
- Mat: 221 Lotus-Flower massagers with 25 petals each
- Mat & Mini: Mattress: 100% natural coconut fiber
- Mat & Mini: Mattress cover: 100% untreated cotton
- Lotus-Flower massagers: HiPS plastic. Safe for health also used in food packaging and toys.

100% Pranamateco ECO
We guarantee genuine and original Pranamateco ECO products.

Payment Options
Secure payment with PayPal, Skrill, Visa, MasterCard (and American Express via PayPal)

Worldwide Shipping
We deliver worldwide within 3-5 business days

30-day returns
30-day no-questions-asked money-back guarantee on item cost

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⁸⁰ D. Grigorenko Decl. ¶ 4(f) (April 23, 2021 Request for Reconsideration at TSDR 17). The testimony of Applicant’s declarants regarding visits and page views again appears to be in conflict. Vladimirs Grigorenko’s testimony covers the period between 2010 and March 6, 2020, while Deniss Grigorenko’s testimony covers the period from August 28, 2016 to April 23, 2021 and does not address visits and page views from 2010 until August 28, 2016. We will accept Deniss Grigorenko’s higher figures for purpose of our analysis of this *Converse* factor.

⁸¹ April 23, 2021 Request for Reconsideration at TSDR 40-41 (pranamateco.com, accessed on March 5, 2020) (highlighting supplied by Applicant). This page, and others in the record,

Advantages

- Supreme Quality**
Pranamate ECO is the only patented product on the market backed by health certificates and clinical data.
- Eco-friendly Materials**
Made from 100% linen, odor-free cotton, natural coconut fiber and HIPS plastic.
- Handcrafted**
Hand-made in Europe, to the most rigorous standards. We take pride in every stitch.
- Fast Results**
You will notice an easing of muscle-tension and pain, better sleep and higher productivity days before the trial period is over.
- 5-year Warranty**
The spendurable Pranamate ECO comes with a five-year warranty.
- Ethically-produced**
In-house craftsmanship, good pay and creative work environment.

WHAT PEOPLE SAY ABOUT Pranamate ECO

Don't miss this exclusive offer

\$340
\$238

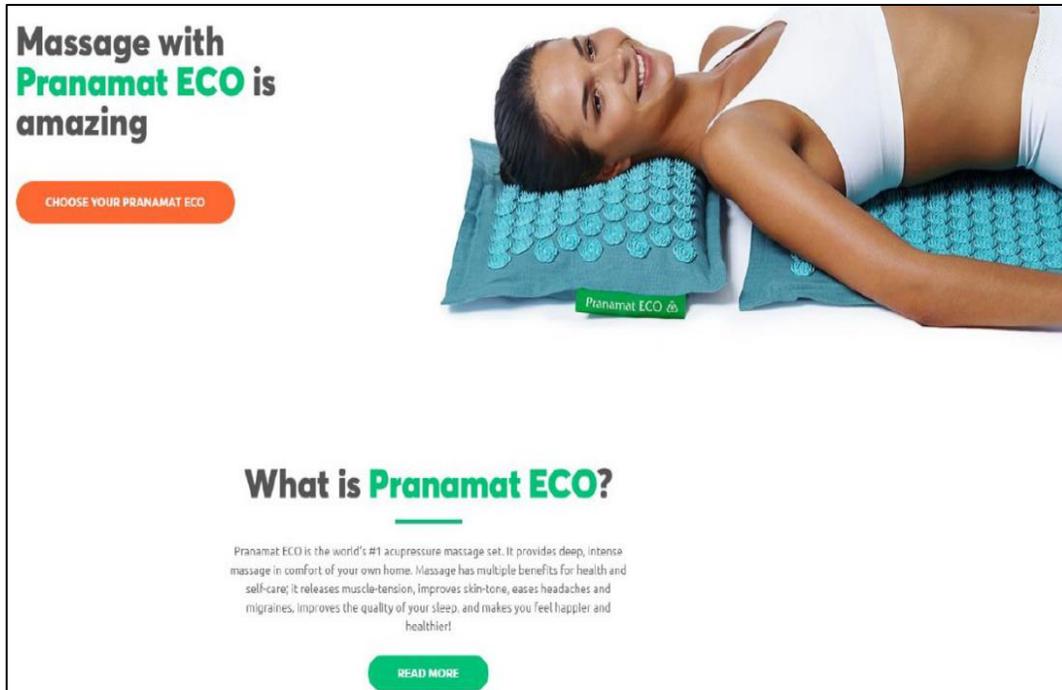
Our ambassadors

- @tenilledashwood**
Took my Pranamate massage set out by the pool today to get some sun while I relieved some stress and aches.
[VIEW INSTAGRAM](#)
- @realfoodology**
The pressure from laying on the @pranamate releases endorphins and gives you a little sting of natural energy!
[VIEW INSTAGRAM](#)
- @janiceliou**
Took some much needed time with my Pranamate (my personal manual therapist) for spinal health to decrease and pain relief.
[VIEW INSTAGRAM](#)

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including some shown below, are somewhat blurry and difficult to read, even when enlarged, and “it was Applicant’s duty to ensure that the evidence it submitted is legible.” *In re Sausser Summers, PC*, 2021 USPQ2d 618, at *24 n.59 (TTAB 2021). “[W]e have considered this evidence to the extent it is legible and we are able to read the entire context of the evidence.” *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014). The highlighted portion of the bullet point on the page above reads “Mat: 221 lotus-flower massagers with 25 petals each.” There are other references on the page to the HIPS plastic from which the “Lotus-flower massagers” are made, and two bullet points stating “Pillow: 95 lotus-flower massagers with 25 petals each” and “Mini: 95 lotus-flower massagers with 25 petals each.”

⁸² April 23, 2021 Request for Reconsideration at TSDR 43 (pranamateco.com, accessed on March 9, 2020).



Massage with Pranamat ECO is amazing

CHOOSE YOUR PRANAMAT ECO

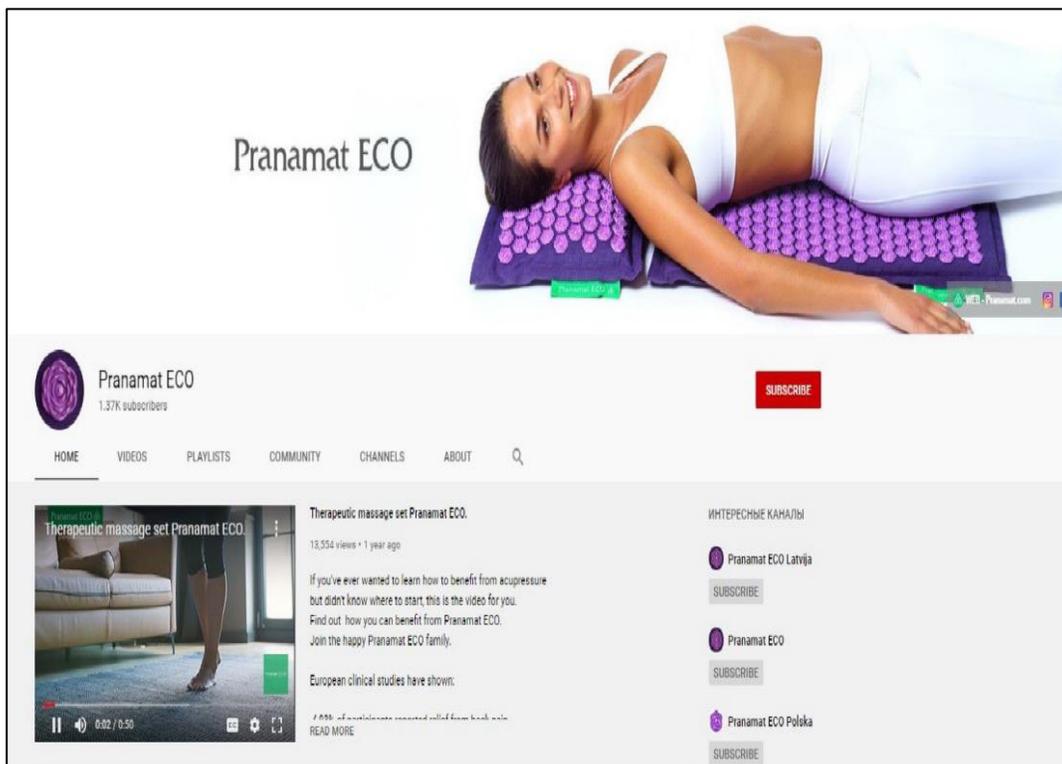
Pranamat ECO

What is Pranamat ECO?

Pranamat ECO is the world's #1 acupressure massage set. It provides deep, intense massage in comfort of your own home. Massage has multiple benefits for health and self-care; it releases muscle-tension, improves skin-tone, eases headaches and migraines, improves the quality of your sleep, and makes you feel happier and healthier!

READ MORE

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Pranamat ECO

Pranamat ECO
1.37K subscribers

SUBSCRIBE

HOME VIDEOS PLAYLISTS COMMUNITY CHANNELS ABOUT Q

Therapeutic massage set Pranamat ECO.
13,554 views • 1 year ago

If you've ever wanted to learn how to benefit from acupressure but didn't know where to start, this is the video for you. Find out how you can benefit from Pranamat ECO. Join the happy Pranamat ECO family.

European clinical studies have shown:

7,896 of participants reported relief from back pain

READ MORE

ИНТЕРЕСНЫЕ КАНАЛЫ

- Pranamat ECO Latvija
SUBSCRIBE
- Pranamat ECO
SUBSCRIBE
- Pranamat ECO Polska
SUBSCRIBE

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⁸³ *Id.* at TSDR 42 (pranamateco.com, accessed on March 9, 2020).

⁸⁴ *Id.* at TSDR 45 (youtube.com, accessed on March 9, 2020).

Therapeutic massage set Pranamat ECO.
13,363 views · 1 year ago

If you've ever wanted to learn how to benefit from acupressure but didn't know where to start, this is the video for you. Find out how you can benefit from Pranamat ECO. Join the happy Pranamat ECO family.

European clinical studies have shown:
A 100% improvement in chronic relief from back pain.
[READ MORE](#)

Pranamat ECO- acupressure massage set ▶ PLAY ALL

- First massage sessions on Pranamat ECO.**
Pranamat ECO
16K views · 1 year ago
- How To Use Pranamat ECO Set?**
Pranamat ECO
142 views · 1 month ago
- Therapeutic massage set Pranamat ECO.**
Pranamat ECO
13K views · 1 year ago
- Pranamat ECO Production**
Pranamat ECO
294 views · 1 year ago
- Pranamat ECO vs Alternative**
Pranamat ECO
1.2K views · 1 year ago

Back Pain Relief with Pranamat ECO ▶ PLAY ALL

- Tips from Shonda: Back Pain Survivor!**
Pranamat ECO
203 views · 1 year ago
- Jewess's best friend: Pranamat ECO**
Pranamat ECO
290 views · 1 year ago
- Natural remedy: Pranamat ECO**
Pranamat ECO
331 views · 1 year ago
- For new moms: how to alleviate lower back and...**
Pranamat ECO
210 views · 1 year ago
- Back pain relief within 20 minutes.**
Pranamat ECO
186 views · 1 year ago

Skin-toning with Pranamat ECO ▶ PLAY ALL

- Firm up the skin on your tummy.**
Pranamat ECO
186 views · 1 year ago
- Acupressure: natural remedy to reduce cellulite**
Pranamat ECO
279 views · 1 year ago
- Youtuber Jellydevote tries acupressure massage.**
Pranamat ECO
195 views · 1 year ago
- Jessica Giselle is using Pranamat ECO**
Pranamat ECO
305 views · 1 year ago
- Jellydevote demonstrates how to use Pranamat ECO.**
Pranamat ECO
682 views · 1 year ago

Pranamat ECO Reviews ▶ PLAY ALL

<http://www.pranamat.com> Here are some Pranamat ECO reviews by some lovely Pranamat ECO users! Check out what they have to say!

- Product Review: Pranamat ECO & Back Pain**
YOSATX
23K views · 3 years ago
- Back Pain Relief & the Pranamat ECO: Product...**
PsycheTruth
14K views · 5 years ago
- Muscle Recovery: Pranamat ECO - Health Tips**
Matthew Brian Brown
11K views · 4 years ago
- How To Get Rid Of Muscle Pain AT HOME / Pranamat...**
Alma Moleed
6.5K views · 1 year ago
- Pranamat ECO explained.**
Pranamat ECO
5K views · 1 year ago

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pranamat Follow

877 posts 181k followers 151 following

Pranamat ECO
Nº1 acupressure massage set
OEKO-TEX certified
Handmade in Europe Lv
pranamateco.com

REVIEWS TRIAL PER... MATERIALS WARRANTY

POSTS IGTV TAGGED

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⁸⁵ *Id.* at TSDR 46 (youtube.com, accessed on March 9, 2020).

⁸⁶ *Id.* at TSDR 47 (Instagram, accessed on March 9, 2020).

The screenshot displays the Facebook profile for 'Pranamate ECO'. At the top, the page name 'Pranamate ECO' is visible in the search bar. The profile picture shows a woman lying on a massage mat. The cover photo is a larger image of the same woman lying on her back on a massage mat and pillow. Below the cover photo are buttons for 'Like', 'Follow', 'Share', 'Shop Now', and 'Send Message'. The left sidebar contains navigation options: Home, Posts, Reviews, Trustpilot Reviews, Shop, Videos, Instagram, About, Community, Photos, and Groups. A 'Create a Page' button is at the bottom of the sidebar. The main content area features a 'Create Post' section with a 'Write a post...' prompt and options for 'Photo/Video', 'Tag Friends', and 'Check in'. Below this is a post from 'Pranamate ECO' dated February 6, which reads: 'Pranamate ECO is feeling thankful in Birmingham, United Kingdom. Pranamate ECO supports NHS Midwives! We were so touched by this pic from University Hospital Birmingham. We just had to share it! We all know that giving birth hurts. But being a midwife also plays havoc with your back! Long shifts. Longer overtime. Stress. Overwork. The overwhelming responsibility of bringing precious little bubbas safely into the world. "We help our patients manage their pain with TENS machines all the time. So we know how powerful endorphins are in relieving pain. We are so chuffed to be able to have a massage on shift. Pranamate makes the world of difference I can tell you".

On the right side of the page, there is a 4.9 star rating based on 281 reviews. Below this is a 'Community' section showing 36,901 likes, 37,856 followers, and 55 check-ins. An 'About' section provides contact information: phone number +44 20 3769 1910, website pranamateco.com, and business hours (Opens tomorrow, Closed Now). A 'Suggest Edits' button is located at the bottom right of the page.

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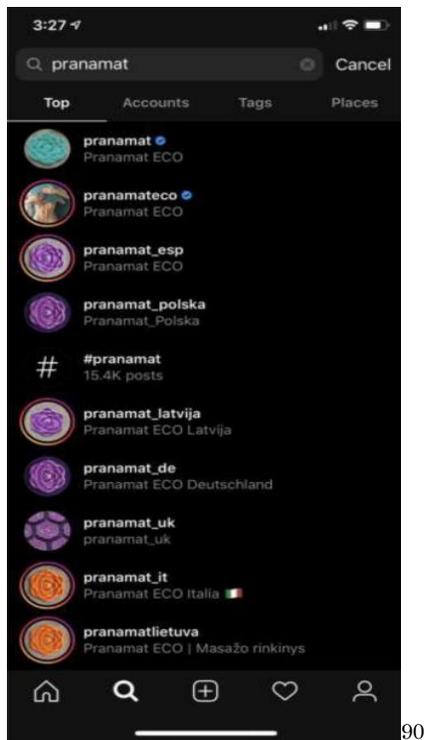
⁸⁷ *Id.* at TSDR 81.

The screenshot shows a Facebook post from the page 'Pranamat ECO' (@Pranamat). The post features a photograph of two women in a spa setting standing behind a massage table with two green, textured mats. The post has 357 likes, 33 comments, and 10 shares. Below the photo, the text reads: 'Pranamat ECO is in London, United Kingdom. 4 hrs - Mother's day is coming, so we decided to surprise everyone with special deals. Starting today and up until March 11 we've got fantastic offers for everyone, who is looking for a perfect gift for their mom. If you order during this limited-time offer, we guarantee on-time delivery. Even limited colors are on sale. Pranamat ECO has been proven: clinically and by our customers. Health experts recommend Pranamat ECO as a great gift for someone you love! You'll notice that... See More'. The right sidebar shows a list of pages liked by this page, including 'Positive Thinking Life Health & Wellness Website', 'Mindfulness Quotes Organization', 'Sixpenny Furniture', 'Pranamat ESP', 'Pranamat ECO Latvija', and 'Pranamat ECO Russia'. At the bottom right of the page, the number '88' is visible.

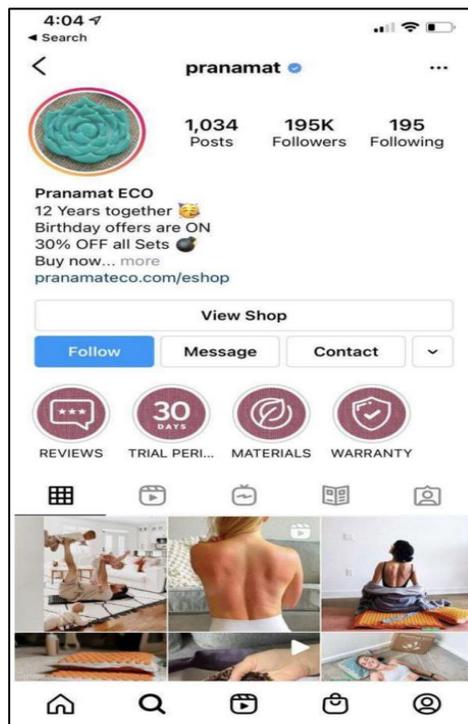
The screenshot shows a Facebook post from the page 'pranamat' (San Francisco, California). The post features a photograph of three orange, textured mats with 'Pranamat ECO' labels, arranged on a wooden floor next to wrapped gifts and string lights. The text of the post reads: 'Missing your loved ones this year? 😊 We deliver worldwide and can reach the people you care about. ❤️ If you want to make someone you love happier, Pranamat ECO can help! A massage a day is proven to reduce stress, ease headaches, relieve aches and pains and ensure a peaceful night's sleep. 😊 "This is awesome", "It's a life-changer", "It gives you an intense, deep massage"— this is what our customers are saying! 🗣️ We believe happiness starts with wellness. So, give you loved ones a chance to try massage at home for...'. Below the text are icons for liking, commenting, and sharing. It shows the post was liked by 'ryannavalentino and others' on 'DECEMBER 3, 2020'. At the bottom right of the page, the number '89' is visible.

⁸⁸ *Id.* at TSDR 83.

⁸⁹ *Id.* at TSDR 192.



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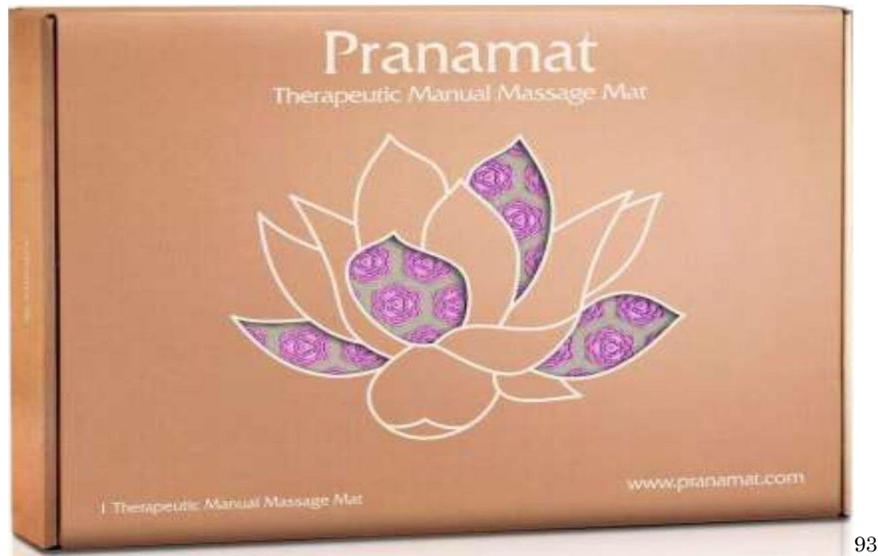


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⁹⁰ *Id.* at TSDR 19 (Instagram).

⁹¹ *Id.* at TSDR 20 (Instagram).

Deniss Grigorenko also testified that Applicant has used the images shown below on its website and packaging as a form of advertising:



As noted above, “[w]hen advertisements are submitted as evidence of acquired distinctiveness, they must demonstrate the promotion and recognition of the specific

⁹² D. Grigorenko Decl. ¶ 4n (August 23, 2021 Request for Reconsideration at TSDR 25).

⁹³ D. Grigorenko Decl. ¶ 4o (August 23, 2021 Request for Reconsideration at TSDR 26).

configuration embodied in the applied-for mark and not of the goods in general,” *OEP Enters.*, 2019 USPQ2d 309323, at *23 (quoting *Kohler*, 125 USPQ2d at 1516), and it “is well established that without any advertising directing consumers to the identifiable features of Applicant’s [goods], typically consumers are unlikely to notice that feature of trade dress design, let alone perceive it as being exclusively associated with a single source.” *Larian*, 2022 USPQ2d 290, at *44 (citing *Kohler*, 125 USPQ2d at 1517 n.97).

While there are a few visual and verbal references in Applicant’s advertising that highlight or draw attention to Applicant’s lotus flower spikes, most of Applicant’s advertisements on its website and social media pages “do little more than show the products, and they do not establish that consumers associate the features of the applied-for mark with Applicant.” *OEP Enters.*, 2019 USPQ2d 309323, at *25.⁹⁴ Some of Applicant’s advertisements show an individual lotus flower (as do some of the advertisements of competitive products shown above), but there is nothing “that directs [Applicant’s] potential consumer in no uncertain terms to look for a certain feature to know that it is from that source,” *id.*, at *24 (quoting *Kohler*, 125 USPQ2d

⁹⁴ Deniss Grigorenko testified to impressive numbers of visitors and visits to Applicant’s websites, viewers of videos featuring Applicant’s products on YouTube (which are not themselves in the record), and subscribers to Applicant’s Instagram pages. D. Grigorenko Decl. ¶ 4e-h (April 23, 2021 Request for Reconsideration at TSDR 17-21). Those numbers alone are not circumstantial evidence of acquired distinctiveness, however, because what matters is what visitors see during their visits to Applicant’s website or social media pages, or while viewing of videos. As explained above, consumers are not conditioned by this advertising and promotion to look for the features of Applicant’s claimed trademark as an indicator of source.

at 1517), such as the 25 petals in each of Applicant’s lotus flowers.⁹⁵ Most of Applicant’s advertising “simply includes a picture of the product itself or touts a feature in a non-source identifying manner.” *Id.* (quoting *Kohler*, 125 USPQ2d at 1517). In Applicant’s advertising, the source of the products is identified as “Pranamat ECO.” “On this record, the absence of advertising directing consumers to the specific features of the applied-for mark undermines Applicant’s claim of acquired distinctiveness based upon its advertising.” *Id.*, at *25 (quoting *Kohler*, 125 USPQ2d at 1517).

3. Amount of Sales and Numbers of Customers

Vladimirs Grigorenko testified that in the nearly 10-year period between 2010 and March 6, 2020, Applicant “sold nearly 23,000 units in [the] US [bearing the claimed trademark] to customers in all fifty states throughout the United States with total sales reaching over \$3,700,000.”⁹⁶ According to his testimony, Applicant’s average annual sales between 2010 and March 2020 were about 2,300 units generating about \$370,000 in annual revenue. Deniss Grigorenko testified that in the nearly 11-year period between 2010 and April 23, 2021,⁹⁷ Applicant “sold over 46,000 units in [the] US [bearing its claimed trademark] to customers in all fifty states throughout the

⁹⁵ The references in the “Materials” section of Applicant’s website to the fact that Applicant’s lotus flowers contain “25 petals each” do not instruct consumers to look for that feature to identify Applicant’s goods, or that the feature is unique to Applicant. The more plausible takeaway from those references is that there are a large number of “petals” in Applicant’s lotus flowers and that the therapeutic benefits of Applicant’s acupuncture mats and pillows will be greater due to that number.

⁹⁶ First and Second V. Grigorenko Decls. ¶ 4d (March 9, 2020 Response to Office Action at TSDR 3; September 30, 2020 Response to Office Action at TSDR 41).

⁹⁷ D. Grigorenko Decl. ¶ 2 (April 23, 2021 Request for Reconsideration at TSDR 16).

United States with total sales reaching over \$7,3 million.”⁹⁸ According to his testimony, Applicant’s average annual sales between 2010 and April 2021 were about 4,200 units generating about \$660,000 in annual revenues.

Deniss Grigorenko’s testimony again conflicts with Vladimirs Grigorenko’s earlier testimony unless we assume that Applicant’s sales between March 6, 2020 and April 23, 2021 were about double the total sales during the entire period between 2010 and March 6, 2020. But even if we again accept Deniss Grigorenko’s more favorable testimony of higher unit sales and revenues since 2010, “[o]n its face, this does not seem to be a significant number of [goods] sold each year,” *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001), or in the aggregate, or a significant amount of annual or aggregate revenue resulting from the sales.

As shown and discussed above, there have been numerous brands of acupressure mats and pillows containing self-described “lotus flowers,” or other types of “spikes” or pressure points, that have been sold in the United States.⁹⁹ While Applicant provides relevant sales information, it “does not provide any evidence regarding the number of its actual customers . . . or overall market context,” *Larian*, 2022 USPQ2d

⁹⁸ D. Grigorenko Decl. ¶ 4d (April 23, 2021 Request for Reconsideration at TSDR 17).

⁹⁹ September 9, 2019 Office Action at TSDR 2-3 (ProSource), 5-6 (Artree), 7-8 (Dosha Mat), 10 (Kendal and DG Sports), 11-12 (Gaiam), 13 (Kenko); March 31, 2020 Office Action at TSDR 2 (Lotus Acupuncture), 5 (Master Smart Gear), 6 (Spoonk), 7, 9 (Nayoya), 8 (ZenGuru), 10 (VitaliZen), 12 (Bed of Nails), 13 (White Lotus); October 23, 2020 Final Office Action at TSDR 5 (Body Quiet Floor Pillow), 9 (Beauty), 10 (Zensation), 11 (Prickly Lotus), 15 (Ajnamat), 18-19 (Peppy Elements), 21 (Garden of Alice), 23 (Mylotusmat), 27 (Luckybudmall), 28 (Enjife); May 21, 2021 Denial of Request for Reconsideration at TSDR 9-10 (Medic Therapeutics), 11 (Kowth), 12 (Dr. Relief), 13 (Mayyosuru), 14 (Mchuxin), 15, 27-28 (Kanjo), 16 (XiaoKa), 17 (TimeBeeWell), 18 (Yakario), 20 (Benooa), 21 (DDPD), 22 (Todaytop), 25-26 (Pomnefe), 30 (Winnereco).

290, at *45, or break down its sales in terms of the multiple goods identified in Classes 10, 20, and 27 in its application.¹⁰⁰ As a result, “[w]e cannot accurately gauge Applicant’s level of success without additional evidence as to Applicant’s market share or how [its products] rank[] in terms of sales in the trade.” *Id.* As the Board explained in *Larian*, “[o]ur precedents have long alerted practitioners to the fact that the absence of evidence of competitive contextual information may limit the probative value that we might otherwise accord advertising and sales numbers in the acquired distinctiveness inquiry,” *id.*, and that is the case here. In the absence of such “competitive contextual information,” we find that Applicant’s evidence on this *Converse* factor does not support a finding that Applicant’s claimed trademark has acquired distinctiveness.

4. Intentional Copying

In its appeal brief, Applicant claims that it “notified owners of . . . several infringing products or e-commerce platforms on which the products are sold about the infringement and actively pursuing [sic] removal of such infringing materials from the market,” and that the “Examining Attorney’s evidence suggests that market participants almost always use numerous alternative designs . . . and almost never try to replicate Applicant’s mark” 9 TTABVUE 9. In its supplemental brief, Applicant similarly claims that the “fact that [the] majority of such infringers promptly remove infringing products demonstrates that Applicant effectively

¹⁰⁰ Applicant’s declarants simply aver that Applicant has sold “acupuncture and massaging devices and related retail services.” First and Second V. Grigorenko Decls. ¶ 4b (March 9, 2020 Response to Office Action at TSDR 3; September 30, 2020 Response to Office Action at TSDR 41); D. Grigorenko Decl. ¶ 4b (April 23, 2021 Request for Reconsideration at TSDR 17).

exercises its intellectual property rights in [its claimed trademark] and [its claimed trademark] is recognized as a source-identifier associated with Applicant by third parties.” 20 TTABVUE 13. Applicant again argues that the “Examining Attorney’s evidence suggests that market participants almost always use numerous alternative designs,” and that “many others, almost never try to replicate Applicant’s Mark . . . and even if some of them do they promptly remove infringing materials from the market.” *Id.* at 14.

As noted above, there is no testimony or other evidence to support Applicant’s arguments regarding its enforcement efforts. *Cf. Larian*, 2022 USPQ2d 290, at *49 (“Applicant’s indefinite testimony of its enforcement efforts - together with the record evidence of third-party use - further undercuts Applicant’s assertion of substantially exclusive use. In view thereof, we find that Applicant has failed to demonstrate the ‘substantially exclusive’ use of the purported mark required by the statute.”). This *Converse* factor does not support a finding that Applicant’s claimed trademark has acquired distinctiveness.

5. Unsolicited Media Coverage of Goods Embodying the Claimed Trademark

In *Larian*, the Board considered unsolicited media coverage of the applicant’s products not just in traditional media such as newspapers and magazines but in social media as well. *Larian*, 2022 USPQ2d 290, at *49-51. Here, Applicant offers one newspaper article and a number of comments in social media.

Deniss Grigorenko testified that Applicant’s claimed trademark “has been featured in multiple popular publications, for example, *New York Post* and others.”¹⁰¹ He did not identify any of the “others,” and he attached to his declaration a single May 2018 *New York Post* article, which he stated “features [Applicant’s claimed trademark] as a source identifier of PRANAMAT products and prominently displays” the claimed trademark.¹⁰² We reproduce the article below:



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¹⁰¹ D. Grigorenko Decl. ¶ 41 (April 23, 2021 Request for Reconsideration at TSDR 24).

¹⁰² *Id.*

¹⁰³ D. Grigorenko Decl. ¶ 41 (April 23, 2021 Request for Reconsideration at TSDR 31, 89-92).

The article stated in pertinent part that Applicant’s acupuncture mat and pillow had “tiny rubber spikes so hard and pointy, you could easily hammer them into drywall,” and stated that the spikes were “the defining feature of the Pranamat Eco (\$160), an acupuncture mat that’s been quietly taking over Instagram in recent months.”¹⁰⁴ The rest of the article described the author’s somewhat negative and painful experience trying the product.

We do not view this article as “featur[ing] [Applicant’s claimed trademark] as a source identifier of PRANAMAT products,” or as “prominently display[ing] [the claimed trademark],”¹⁰⁵ as Applicant’s declarant claimed. Like most of Applicant’s advertising, the article displayed Applicant’s products in use, and it also provided a close-up of what the article described as the “hard, spiky Pranamat.” The only mention of a “lotus” design was with respect to yogis, whose “perfect legs, butts and backs” are all “imprinted with rashy-looking marks from [the mat’s] plastic ‘lotuses.’” The article stated that the “trendy mat is popular on Instagram,” but there is no reference to the “plastic lotus” as an identifier of the mat’s source. This one article regarding Applicant’s product, over an 11-year period of sales in the United States, does not support a finding of acquired distinctiveness. *Cf. Larian*, 2022 USPQ2d 290, at *50 (noting that articles featuring the applicant’s bag had “appeared in InStyle, People Magazine, The New York Times, US Weekly, Fashion Bomb Magazine,

¹⁰⁴ D. Grigorenko Decl. ¶ 41 (April 23, 2021 Request for Reconsideration at TSDR 31, 89-92).

¹⁰⁵ D. Grigorenko Decl. ¶ 41 (April 23, 2021 Request for Reconsideration at TSDR 24).

Fashionista, and Glamour,” as well as STAR magazine, reflecting “much favorable press”).

There are multiple mentions of Applicant’s product on third-party social media pages. Deniss Grigorenko identified 17 such mentions,¹⁰⁶ which he claimed “alone demonstrate[d] that [Applicant’s claimed trademark] is actively and routinely advertised to nearly 3 million people in [the] US,”¹⁰⁷ and Applicant cited four of them in its appeal brief. 9 TTABVUE 10-11. Deniss Grigorenko also testified about comments about Applicant’s products by three bloggers, including the American actress, model, and TV host Jenny McCarthy.¹⁰⁸

Deniss Grigorenko’s declaration contained what appear to be links to instagram.com with respect to the comments of the 17 “popular US bloggers and online influencers,”¹⁰⁹ what appear to be links to the websites at jennymccarthy.com, hazeleyesmom.com, and addressmagazine.com, and what appears to be a screenshot with a user’s comments on Applicant’s Facebook page,¹¹⁰ but neither he nor Applicant’s appeal brief provided record citations for these materials.¹¹¹

Turning first to the three bloggers, we could not locate any pages from the websites at jennymccarthy.com and hazeleyesmom.com in the 438 pages attached to

¹⁰⁶ D. Grigorenko Decl. ¶ 4i (April 23, 2021 Request for Reconsideration at TSDR 22-23).

¹⁰⁷ D. Grigorenko Decl. ¶ 4i (April 23, 2021 Request for Reconsideration at TSDR 23).

¹⁰⁸ D. Grigorenko Decl. ¶ 4t (April 23, 2021 Request for Reconsideration at TSDR 29-30). Ms. McCarthy’s alleged blog comments are not discussed by Applicant in its appeal brief.

¹⁰⁹ D. Grigorenko Decl. ¶ 4i (April 23, 2021 Request for Reconsideration at TSDR 22-23).

¹¹⁰ D. Grigorenko Decl. ¶ 4j (April 23, 2021 Request for Reconsideration at TSDR 23-24).

¹¹¹ As noted above, Applicant’s appeal brief does not discuss the bloggers.

Deniss Grigorenko's declaration.¹¹² "[T]he Board does not consider websites for which only links are provided," *Hikari Sales USA*, 2019 USPQ2d 111514, at *5 n.13 (citing *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017)), and we will not consider the comments that Deniss Grigorenko attributes to Ms. McCarthy or the "Hazel Eyes Mom" on their websites.

Pages from the 2017 website at addressmagazine.com are in the record.¹¹³ They show Applicant's mat and pillow, and discuss the blogger's satisfaction with the products and the way in which they work. In the middle of a paragraph on the second page of the blog, the blogger states that the "mat's signature lotus pattern individually massages each of the body's meridian points when one lies against the mat."¹¹⁴ The blogger also mentions the mat's "superior quality, elegant design and beautiful materials,"¹¹⁵ and notes that "[t]he lotus-shaped flower massagers are made from surgical-grade HIPS plastic that is hyperallergic and EU-approved," that the product "works on the premise that the tiny lotus spikes stimulate active nerve centres and intensify the local blood flow and lymph circulation,"¹¹⁶ and that there "are in total 221 elegant lotus flowers, each with 25 sharp, non-toxic petals, for an

¹¹² Vladimirs Grigorenko also testified about the same three bloggers and provided the same three links, Second V. Grigorenko Decl. ¶ 4t (September 30, 2019 Response to Office Action at TSDR 49-50), but no webpages from the websites of the bloggers were attached to his declaration.

¹¹³ April 23, 2021 Request for Reconsideration at TSDR 434-37.

¹¹⁴ *Id.* at TSDR 435.

¹¹⁵ *Id.*

¹¹⁶ *Id.*

aggregate of 5,525 petals.”¹¹⁷ The blog’s single buried reference to “the mat’s signature lotus pattern” has limited probative value of acquired distinctiveness. *Cf. Larian*, 2022 USPQ2d 290, at *50 (multiple “favorable reviews and feature stories in media where, for example, the Ark bag is referred to as ‘signature’, ‘iconic’, ‘viral’, [or] ‘famous,’” weighed in Applicant’s favor on the issue of acquired distinctiveness).

With respect to comments in social media, including by influencers, Deniss Grigorenko listed 17 commentators,¹¹⁸ and we were able to locate comments by all of them in the record.¹¹⁹ There are several issues with the comments.

First, three of the bloggers, Dr. Bradley Shaeffer, Kathy Wakile, and Marissa Kai Miluk, acknowledge that they have a “[p]aid partnership with pranamat.”¹²⁰ At the very least, such a relationship with Applicant suggests that their comments were neither unsolicited nor objective.

¹¹⁷ *Id.* at TSDR 436. The reference to EU approval of the product, another mention in the blog that the mat is made in Europe with European-certified materials, and the spelling of the word “centres” in British English, suggest that the blogger is in the United Kingdom, not the United States. If that is the case, the blogger’s comments do not reflect the views of a United States consumer, and, in any event, we do not know whether and to what extent the blog was read by United States consumers.

¹¹⁸ D. Grigorenko Decl. ¶ 4i (April 23, 2021 Request for Reconsideration at TSDR 22-23). His declaration quoted the alleged comments of only three of the 17 persons.

¹¹⁹ April 23, 2021 Request for Reconsideration at TSDR 32 (Caley Alyssa), 65-66, 152 (Kathy Wakile), 69-70, 149 (Dr. Bradley Schaeffer), 125 (Kristina Carrillo-Bucaram), 128 (“Hungry Runner Girl”), 131 (“Court, Zach & Madi”), 134 (Meg Kilcup), 137 (Sam Previte), 140 (Brittney Nolte), 143 (Kat Napolitano), 146 (Marissa Kai Miluk), 155 (“Helen & Lisa”), 158 (Abbey Bates), 161 (“Maria | Holistic Nutritionist,” who appears to be Maria Marlowe), 164 (Kayla Nielsen), 168 (“JESSI | Food Freedom Coach”), and 171 (Micheline Maalouf).

¹²⁰ *Id.* at TSDR 146, 149, 152. The record contains another instance in which a commentator has partnered with Applicant in the form of a “partnered post” at the website at myboysandtheirtoys.com. *Id.* at TSDR 119.

Second, while Deniss Grigorenko purports to identify the number of followers that each blogger has,¹²¹ he does not explain the basis for his claims and all but one of the Instagram pages in the record do not list the number of followers.¹²² We thus cannot determine how widely the bloggers' comments were exposed.¹²³

Third, in two instances, the Instagram pages in the record do not contain the statements that Deniss Grigorenko attributes to the commentators,¹²⁴ and a third page does not show or mention Applicant's products.¹²⁵

Fourth, and most importantly, none of the commentators characterizes or describes Applicant's product, much less Applicant's claimed trademark, as a "signature", "iconic", "viral", [or] "famous" product or feature. *Larian*, 2022 USPQ2d 290, at *50. Only three of them show Applicant's products, and all of them focus on

¹²¹ D. Grigorenko Decl. ¶ 4i (April 23, 2021 Request for Reconsideration at TSDR 22-23).

¹²² The exception is the Instagram page of Kathy Wakile. Deniss Grigorenko claims that she has "440,000 followers," D. Grigorenko Decl. ¶ 4i (April 23, 2021 Request for Reconsideration at TSDR 22), but her page states that she has 419,000 followers. April 23, 2021 Request for Reconsideration at TSDR 152. "[T]hird-party posts and comments thereto, for example, on the Internet, are relevant to consumer perception of the applied-for mark, apart from the underlying truth of the contents of such posts and comments," *Larian*, 2022 USPQ2d 290, at *23, but we are not required to consider the number of followers listed on Ms. Wakile's page for the truth of that assertion. *Cf. WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018) ("Opposer's Internet evidence is only probative for what it shows on its face and not the truth of what has been printed.").

¹²³ The page of one of the bloggers, Abbey Bates, states that she lives in Canada. As a result, her own comments do not reflect the view of a United States consumer, and it is not clear whether and to what extent her blog was read by United States consumers.

¹²⁴ April 23, 2021 Request for Reconsideration at TSDR 125 (Instagram page of Kristina Carrillo-Bucaram); *id.* at TSDR 168 (Instagram page of "Jesse"). The Instagram page of Micheline Maalouf contains most of the statement attributed to her, "[t]he prickly little flowers on the set help get my mind to focus," *id.* at 171, but the rest of this statement is cut off and what is visible appears to be directed to the functioning of the product, not the ability of consumers to recognize its source because of the "prickly little flowers."

¹²⁵ *Id.* at TSDR 137 (Instagram page of Sam Previte).

the products' therapeutic benefits and efficacy, not their unique and source-identifying appearance. Representative comments include statements such as “[t]his @pranamat massage set is a game changer for self care” and a “total life-saver for migraines, muscle tension, combatting fatigue, and so much more;”¹²⁶ “[t]he benefits of this massage set are never ending” and “all I need to destress after a busy day!”¹²⁷ “[f]or those of you with lower-back sensitivities like me, this acupressure mat is a miracle worker;”¹²⁸ “I saw the @pranamat for the first time a few months ago, and wondered how in the world it could help with recovery and then I tried it and yeah, it definitively helps;”¹²⁹ “this massage set is a major game changer!”¹³⁰ and “[t]his massage set[] has done wonders for our family and our time with it has just begun;”¹³¹ as well as statements that a blogger saw a friend “siting on a set covered in little spikey lotus flowers” and bought a set, which is “incredibly well made;”¹³² and that having Applicant’s mat is like “being able to have a massage anytime of the day if my back hurts or I can’t sleep.”¹³³ These comments collectively suggest that Applicant’s mats and pillows are very highly regarded and even loved by many consumers, but

¹²⁶ *Id.* at TSDR 152.

¹²⁷ *Id.* at TSDR 149.

¹²⁸ *Id.* at TSDR 125.

¹²⁹ *Id.* at TSDR 128. A portion of the page that is cut off begins “each of the little points on the set”

¹³⁰ *Id.* at TSDR 134.

¹³¹ *Id.* at TSDR 140.

¹³² *Id.* at TSDR 155.

¹³³ *Id.* at TSDR 158.

they do not establish that Applicant's claimed trademark has acquired distinctiveness.

Other portions of the record not cited by Applicant are modestly more helpful to its case, although most of this evidence similarly focuses primarily on the therapeutic benefits of Applicant's products, not their unique appearance. A review of the products on the website at tovaleigh.com included Ms. Leigh's statements that she is a big fan of Applicant's massage sets,¹³⁴ that the products' "spikey lotus flowers are the best,"¹³⁵ and that Applicant's products are preferable to cheaper products because of the high quality of Applicant's products.¹³⁶ A reviewer of one of Applicant's products on YouTube stated that the Pranamat pillow "comes with and as you can see it's got these really like beautiful little flower shapes."¹³⁷ A reviewer in a second YouTube review touted the fact that the products' "Spiky Lotus Points Provide Deep Intense Massage."¹³⁸

The "Migraine Diva," a blogger who operates a website at themigrainediva.com, reviewed Applicant's products in 2017, and discussed their high quality and efficacy. In the middle of the review, she made two references to Applicant's claimed trademark in her statements that the "Pranamat ECO is different from any other yoga or exercise mat" because "[i]t features dozens of lotus-shaped massage

¹³⁴ *Id.* at TSDR 430.

¹³⁵ *Id.* at TSDR 431.

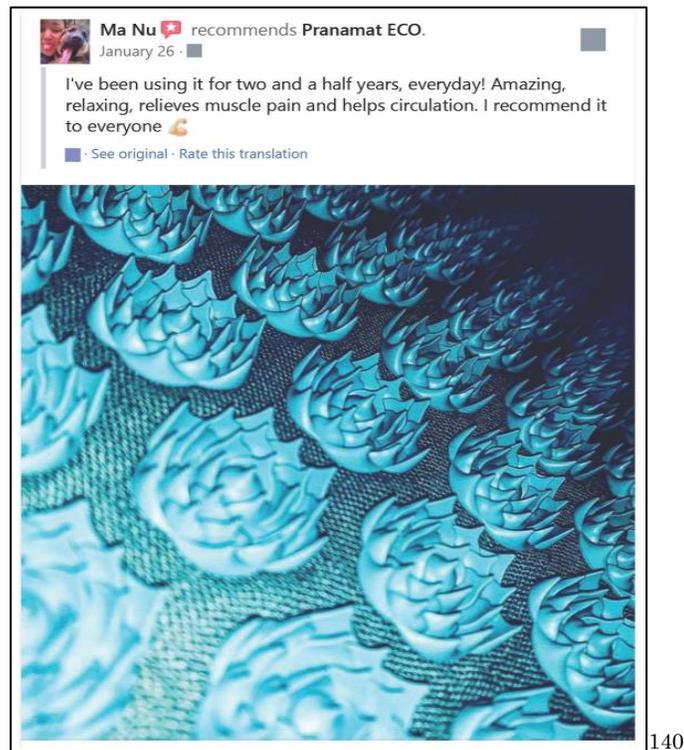
¹³⁶ *Id.* at TSDR 431-32.

¹³⁷ *Id.* at TSDR 458.

¹³⁸ *Id.* at TSDR 462.

stimulators which applies [sic] gentle pressure to problem areas to relieve minor aches, pains and tension throughout the body” and that the “lotus-shaped massage stimulators provides [sic] the exact amount of pressure to the occipital and upper shoulder areas” during migraine headaches.¹³⁹ The review refers to a link through which viewers can purchase the products.

The record also contains a Facebook entry that Applicant refers to in its appeal brief. 9 TTABVUE 11. We reproduce it below:



Like some of the other materials and comments discussed above, the Facebook page shows a close-up of Applicant’s product, with a focus on the lotus flower designs, but the text of the entry recommends the products based on their efficacy.

¹³⁹ *Id.* at TSDR 449-50.

¹⁴⁰ *Id.* at TSDR 96.

Finally, Applicant refers in its appeal brief to what it describes as use of its product feature “as a source identifier of our products in multiple publications,” citing “Paragraph P of the Declaration.” 9 TTABVUE 11. We reproduce below what is displayed in paragraph p of the Deniss Grigorenko declaration:



Source: <https://www.instagram.com/p/CFh1wHIOTJ/>



Source: <https://www.instagram.com/p/BKiUsx0gFAy/>

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¹⁴¹ *Id.* at TSDR 27.



pranamat • Follow

pranamat • Nice evening, unexpected present, sweet tea... and relax with Pranamat. Hope your day ends pleasantly too. pranamat.co.uk #pranamat #pranamateco #relax #relaxation #wellness #evening

313

Liked by lauramiccoli, and others
APR 11, 2019

Add a comment... Post



pranamat • Follow

pranamat • Pranamat inspires!

Message with Pranamat ECO helps you to discover new horizons, stimulates energy, awakens the power. You will be pleasantly surprised at what potential is hidden in you!

#massage #potential #energy #lotus

262

amy_anthea @kat_field
262w Reply

msmarysusanbrasco how can I build up this tolerance?
261w Reply

Liked by lauramiccoli, and others
APR 11, 2019

Add a comment... Post

Source: <https://www.instagram.com/p/BEEG6w-PGRC/>

These pages are from Instagram, which we do not consider to be one of the “multiple publications” in which Applicant claims that its products have been featured, *id.*, but even assuming that the pictures have appeared in publications, they have, at most, modest probative value in proving acquired distinctiveness.

The upper picture on the first page above shows individual lotus petals on fabric to illustrate how they might appear on what the page describes as “[o]ur next limited edition color.” There is nothing in the accompanying text urging consumers to “look for” the petals as non-verbal source identifiers of products from Pranamat ECO. The use of the petals on the cup of coffee in the lower picture on the first page above does draw attention to that feature of Applicant’s products in a context divorced from the products themselves, but the accompanying text again focuses primarily on the efficacy of the product, equating the benefits of its use to drinking a cup of morning coffee. The second page above simply shows Applicant’s claimed trademark and touts the efficacy of the product.

On this record, Applicant’s evidence of unsolicited coverage of its claimed trademark in the traditional media and in social media is considerably weaker than the comparable evidence in *Larian*, in which the Board concluded that this *Converse* factor “weigh[ed] in applicant’s favor.” *Larian*, 2022 USPQ2d 290, at *51. Here, there is only one buried mention of Applicant’s lotus design as the “signature” of its products, and no references to the claimed trademark as the means by which to identify Applicant’s products and distinguish those products from the products of Applicant’s competitors. To the extent that this factor supports Applicant at all,

Applicant’s “evidence alone does not equate to a finding of acquired distinctiveness and is insufficient to overcome the evidence of record in connection with the other factors, which on balance weigh against Applicant.” *Id.*

6. Conclusion

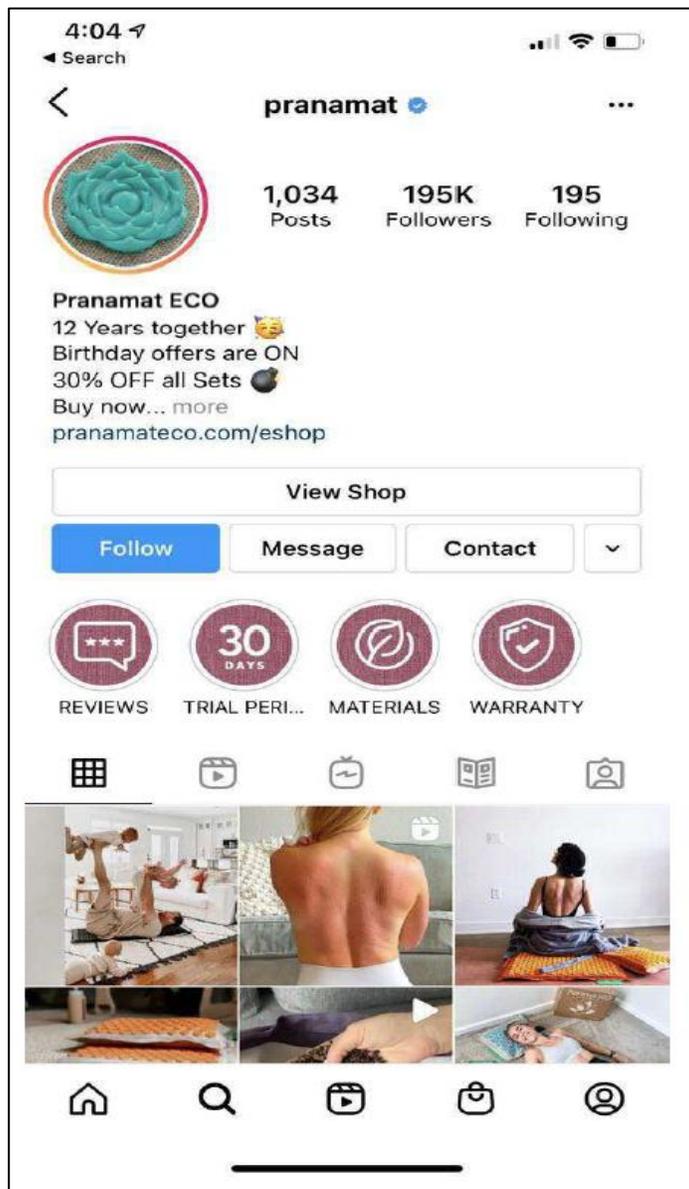
“Overall, this record does not support a finding that consumers perceive the design of Applicant’s [goods] as an indicator of source.” *Id.* Based on a consideration of all the evidence properly in the record, we find that Applicant has fallen far short of showing that its “design embodying the proposed mark has acquired distinctiveness within the meaning of Section 2(f) of the Trademark Act.” *Id.*

IV. Analysis of Whether Applicant’s Claimed Service Mark Functions as a Mark for its Class 35 Services¹⁴³

A product configuration is registrable as a service mark only if it is used in a manner that it is perceived as a mark. *See, e.g., In re Keep A Breast Found.*, 123 USPQ2d 1869, 1880 (TTAB 2017). Applicant argues in its appeal brief that the “Examining Attorney refused registration in class 35 arguing that [Applicant’s claimed service mark] does not function as a service mark because it appears to be a product design for the goods featured in connection with applicant’s retail store services.” 9 TTABVUE 14. Applicant claims that it has “provided multiple examples of how [Applicant’s claimed service mark] is used as a source identifier for retail store

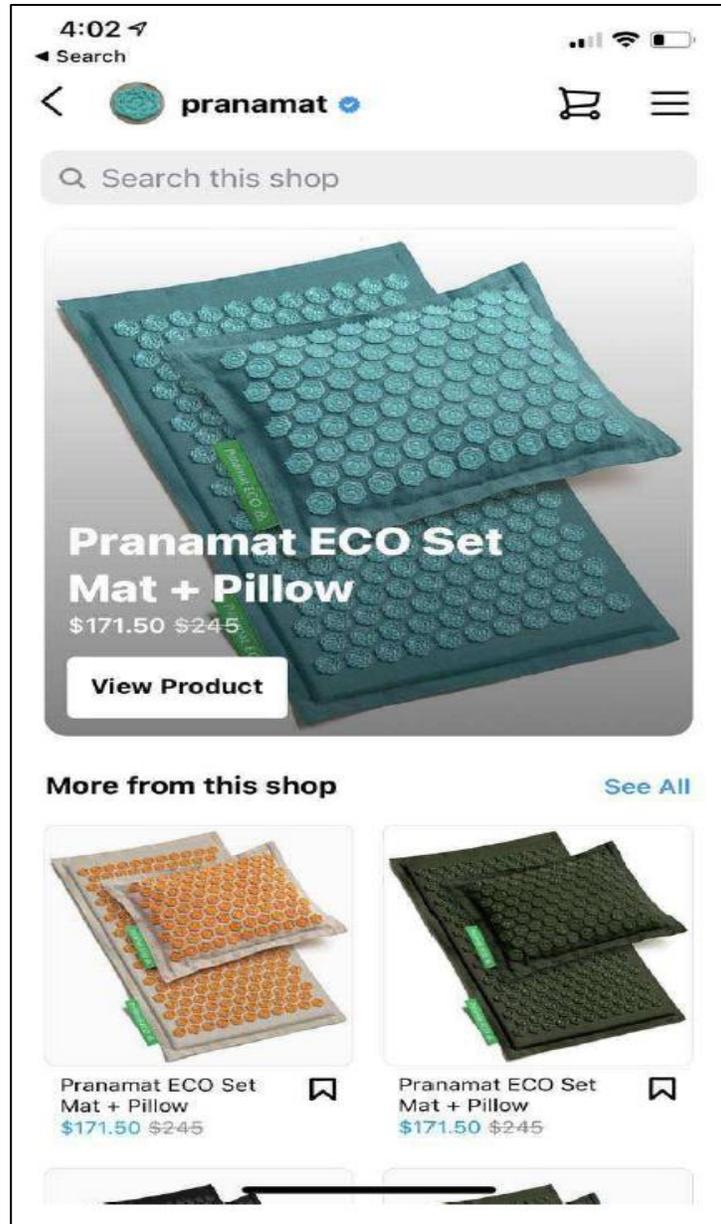
¹⁴³ As discussed above, this application was not filed under Section 1(a) based on a claim of use of the claimed trademark and service mark in commerce, but the record contains evidence of such use, and we may consider it in deciding the failure-to-function refusal. *Cf. In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, at *7 (TTAB 2020) (in deciding a failure-to-function refusal in a Section 44 application, the Board looked to evidence of record that “establishe[d] ways the applied-for designations are used by Applicant and would, if used in the U.S., be perceived by consumers.”).

services, including but not limited to Applicant’s Instagram® (phone version, so no URL link is available) store as shown below.” *Id.* at 15. We reproduce below the Instagram pages displayed in Applicant’s appeal brief:



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¹⁴⁴ April 23, 2021 Request for Reconsideration at TSDR 20. This page appears to show Applicant’s three-dimensional design in the position of a profile picture.



Id. at 15-16.

¹⁴⁵ *Id.* at TSDR 21. The profile picture on this page is smaller and less sharp in resolution than its counterpart on the preceding page, but we will assume for purposes of our analysis that the profile picture on this page also shows a three-dimensional design.

Applicant cites TMEP Section 1301.04(i) “as a guideline of examples of acceptable Service-Mark specimens.” *Id.* at 17. Comparing its use of its claimed service mark to examples of service mark use in that section, one of which is displayed below,



Applicant argues that

the placement of Applicant’s mark in the upper left corner of the online store and explicitly referencing services (“search this shop” or “view shop”) immediately below the mark clearly shows that [Applicant’s claimed service mark] is effectively functioning as a mark for retail services because it creates a strong and direct association between [Applicant’s claimed service mark] and retail services.

Id. at 18.

The Examining Attorney responds that “Applicant’s three-dimensional configuration mark fails to function as a service mark for [the] Class 35 retail services because it merely depicts the design of the products sold in connection with those retail store services.” 11 TTABVUE 15. He notes that

[i]n its brief, applicant contests that it is actually using the mark in commerce as a source indicator for retail store services by using a two-dimensional picture of a lotus flower acupuncture spike as its profile picture on

Instagram, where the goods can be purchased at retail. . . . However, the mark in the drawing, as described by applicant's mark description, is a three-dimensional configuration mark, so the evidence that applicant is purportedly using a two-dimensional image in connection with its retail store services is not probative toward showing that the three-dimensional configuration mark in the drawing functions as a service mark for applicant's class 35 services. Rather, the three-dimensional mark in the drawing does not function as a service mark because it appears to be a product design for the goods featured in connection with applicant's retail store services. . . . Consumers will likely view the mark solely as a product design and not as an identifier of source for the retail services identified—especially since the lotus flower massager configuration is listed under the heading "Materials" in the product description of the retail listing on applicant's website. . . . Accordingly, as the mark consists of "materials" used in a repeating fashion as a component or feature of applicant's goods sold in applicant's retail stores, the mark cannot function as an indicator of source for the retail stores. Consumers will view the lotus configuration as a portion of applicant's product design rather than a source indicator for the Class 35 services.

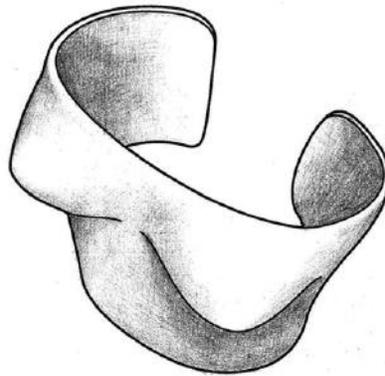
Id. at 15-16 (citations omitted). The Examining Attorney points to pages on Applicant's websites shown above, and other Instagram pages in the record, in support of the failure-to-function refusal. *Id.* at 16.¹⁴⁶

Applicant's arguments are directed to a refusal that was not asserted by the Examining Attorney. The Examining Attorney did not refuse registration with respect to the Class 35 "retail store services and online retail store services featuring . . . acupressure mats, acupressure pillows" and other goods because Applicant's evidence of use did not "show an association between the mark and the services." *See*

¹⁴⁶ September 30, 2020 Response to Office Action at TSDR 54-64.

Keep A Breast Found., 123 USPQ2d at 1876 (citing TMEP Section 1301.04(f)). Instead, the Examining Attorney refused registration because “Applicant’s proposed mark fails to function as a service mark,” *id.* at 1880, on the materials in the record that involve Applicant’s rendition of the identified “online retail store services.” As discussed in *Keep A Breast Found.*, these are distinct refusals. *Id.* at 1876-82.

In *Keep A Breast Found.*, the Board found that a proposed mark described as a “three-dimensional cylindrical cast of female breasts and torso” and shown below



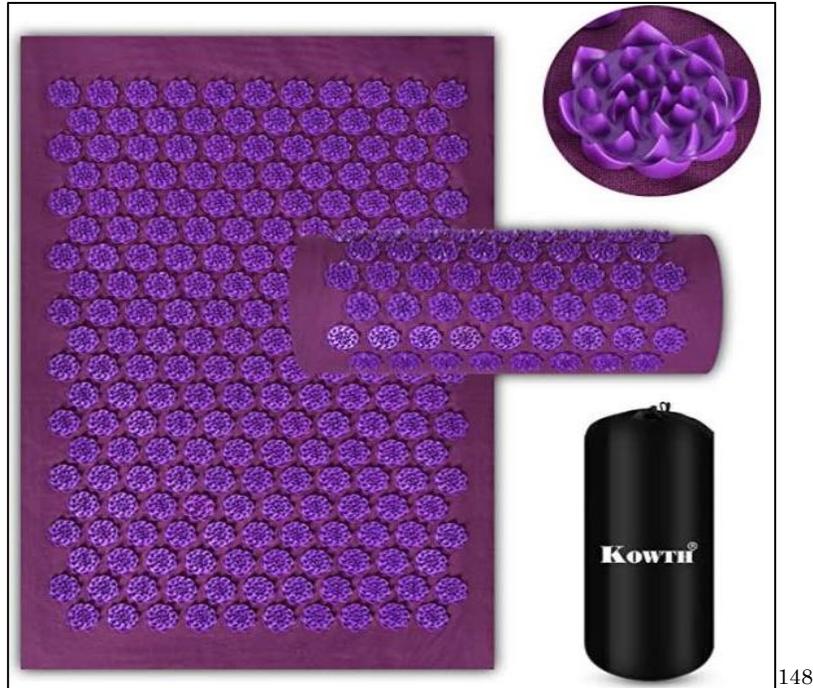
failed to function as a service mark for “Association services, namely, promoting the interests of communities and organizations in the field of breast cancer prevention and awareness, and of providers of educational services in the field of the causes of breast cancer; promoting public awareness of breast cancer prevention” in Class 35, “Charitable fundraising services” in Class 36, and “Educational services, namely, conducting seminars, art exhibitions, and workshops in the field of breast cancer awareness, causes, research and treatment; and entertainment services, namely, live musical performances to promote breast cancer awareness, causes, research and treatment” in Class 41. The Board held that “the central question in determining whether Applicant’s proposed mark functions as a service mark is the commercial

impression it makes on the relevant public (e.g., whether the term sought to be registered would be perceived as a mark identifying the source of the services).” *Id.* at 1879. *See also In re The Ride, LLC*, 2020 USPQ2d 39644, at *5-6 (TTAB 2020).

As noted above, although Applicant’s Section 66(a) application does not rely on use of the claimed mark in commerce, we may look to the record evidence of such use “bearing on consumer perception, including the manner in which Applicant uses its proposed mark[].” *AC Webconnecting*, 2020 USPQ2d 11048, at *7. Here, the claimed service mark appears on social media pages through which Applicant appears to provide online retail store services “featuring . . . acupressure mats, acupressure pillows” and other goods. Consumers viewing Applicant’s use of its claimed service mark on these pages, on which goods embodying the design are shown, are more likely to view the claimed service mark as a close-up depiction of a feature of the goods than as an identifier of the source of the services of selling them. As show above in multiple examples, and as shown again immediately below in two of them, Applicant and other sellers of acupressure mats and pillows embodying lotus flower spikes and similar designs routinely provide close-ups of those product features in various forms:



¹⁴⁷ D. Grigorenko Decl. ¶ 4n (August 23, 2021 Request for Reconsideration at TSDR 25).



There is nothing in the record to suggest that when Applicant’s claimed service mark appears on Instagram pages and other materials, which show goods embodying the same lotus flower design that we have found above does not identify Applicant as the source of the goods, the design would “be perceived as a mark identifying the source of the services” of selling those goods. *Keep A Breast Found.*, 123 USPQ2d at 1879. On this record, we find that Applicant’s claimed service mark fails to function as such.

Decision: The refusals to register Applicant’s claimed trademark in Classes 10, 20, and 27 and Applicant’s claimed service mark in Class 35 are affirmed.

¹⁴⁸ May 21, 2021 Denial of Request for Reconsideration at TSDR 11 (amazon.com). As noted above, Applicant purports to have enforced its claimed rights against others, and if it obtained a registration of its claimed service mark for selling acupressure mats, pillows, and other goods, third-party sellers of such goods who use close-up photographs or illustrations showing lotus flower designs would potentially be exposed to claims for service mark infringement.